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# TRADE MARKS

AND

# MERCHANDISE MARKS

AN EPITOME OF INFORMATION

CONCERNING THE LAWS OF THE COMMONWEALTH OF AUSTRALIA RELATING TO THE

## MARKING OF MERCHANDISE

AND THE

## REGISTRATION AND INFRINGEMENT OF TRADE MARKS

WITH AN

# APPENDIX

CONTAINING THE

TRADE MARKS ACT AND THE COMMERCE ACT

PUBLISHED BY
HEPBURN & SPRUSON, TRADE MARK ATTORNEYS
169 KING STREET, SYDNEY.
1906.

CENTRAL
BOOK COMPANY
261 BROADWAY
NEW YORK
N.Y.
LAW
BOOKS

Hepburn and Spruson, Lawyers
Sydney

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# PREFACE.

THIS Handbook has been compiled for the use of manufacturers, merchants, and those generally whose business involves the handling of goods which are subject to the provisions of various laws relating to marking. It contains the text and a summary of the provisions of the various Commonwealth Acts which require or authorise the application of certain marks to ordinary merchandise and upon articles which are the subject of patent and copyright protection and provide for civil and criminal prosecutions for the application of false and forged marks. In its preparation standard text-books on Trade Marks and Merchandise Marks by Sebastian, Kerly, Fulton and Paul have been freely drawn on, and reference is made wherever necessary to various law reports. It is hoped that the information it contains will be found to be ample for most practical purposes; but in connection with the procuring of Trade Mark registration, and in regard to involved and complicated questions, the reader will find it profitable to seek the advice of an experienced Attorney.

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# Trade Marks and Merchandise Marks.

## Part I.—General Principles and Effect of the Law.

### Legislation.

THE Commonwealth of Australia Constitution Act, 63 & 64 Vict. Ch. 12, enacts (Sec. 51) that the Federal Parliament shall have power to legislate with respect to—

Trade and Commerce with other countries and among the States;
Copyrights, Patents of Invention and Designs, and Trade Marks.

These Federal powers of legislation are not necessarily exclusive.

Pursuant to these powers the Federal Parliament has enacted the following laws:—

Customs Act, 1901.
Patents Act 1903 (Act No. 21 of 1903)
Trade Marks Act 1905 (Act No. 20 of 1905)
Copyrights Act 1905 (Act No. 25 of 1905)
Commerce (Trade Descriptions) Act 1905 (Act No. 16 of 1905)
Designs Act 1906.*

The State laws affecting marking of Merchandise (otherwise than in relation merely to the registration of Trade Marks) remaining wholly or partially in force are the following:—

Victoria:—Trade Marks Act 1890 (Nos. 1 & 2)
South Australia:—Trade Marks Act 1892 (No. 551)
Tasmania:—Patent Designs and Trade Marks Act 1893 (No. 6)
West Australia.—Merchandise Marks Act 1888 (No. 6).

* At date of issue of this book, the Designs Bill was passing through Parliament and had not actually come into force

Various Health Acts and Sale of Poisons Acts touch the subject incidentally.

The policy of the Commonwealth Patent Trade Marks Copyright and Designs Acts is to place all these subjects of Crown grant and registration on the Commonwealth registers, and to bring the old systems of separate State grant and registration, and titles obtained thereunder, to an end as rapidly and completely as circumstances will allow. The Commonwealth Commerce Act deals only with goods imported or exported or intended for export, and does not affect internal manufacture, sale or distribution within the States; but the Commonwealth has power of legislation with respect to trade and commerce among the States.

## State Laws Prior to Federation.

Before these Federal laws were passed, powers of legislation and administration affecting industrial and intellectual property were in the hands of the individual States. In every State, laws provided for the grant of Patents and the registration of Trade Marks, Copyrights and Designs, and in some cases laws controlling the marking of merchandise had been enacted. All the State laws providing for registration of Trade Marks are extinguished by the new Federal laws, which in each case contain provisions of a transitory character and declare that the old laws shall be continued in effect only in so far as is necessary to complete pending proceedings and conserve certain existing rights to a more or less limited extent. When the organisation of the new Federal department has been completed all the old State Records will be under its control. The Merchandise Marks laws passed in some of the States continue in force, but of course only control internal manufacture, sale, or distribution in the States respectively. The Commonwealth Commerce Act controls the marking of goods which are actually imported or exported or intended to be exported.

## Functions of Various Laws.

**The Patents Law** deals only with Patents for inventions. Only two of its clauses are of importance in connection with the marking of goods; these will be referred to later. Those who require information concerning Patents are referred to another work issued by us, devoted exclusively to that subject. It is necessary, however, to say here that the subject matter for which patents may be granted consists for the most part of new or improved processes or methods or machines or mechanical devices, whose structure or operation depend upon some applied principle of mechanics, physics or chemistry, rather than upon shape or form merely. The term of a patent is fourteen years, subject to seven years' extension in exceptional cases. In the case of movable goods a patent relates to the goods themselves, and is not concerned with their marking.

**The Trade Marks and Commerce Acts** deal with the marking of goods, whether such goods are patented or copyrighted articles, or ordinary merchandise.

**The Copyright Act** deals only with literary and artistic productions—books, dramatic works, music, pictures, works of sculpture, &c.

**The Designs Act** deals only with new designs, that is to say, with those novelties which consist in pattern, shape or configuration merely, whether the purpose be utility or ornament. The essence of a Design is in form rather than (as in the case of a Patent) in an involved principle which would permit variation in external appearance without the changing of material character or substance. It contains provisions requiring the marking of registered designs, under penalty.

## Distinction between Patents, Designs, and Trade Marks.

When a patent has been granted, say for a new description or construction of lamp, the manufacture and sale of the lamp become a monopoly, and every lamp of the same or substantially the same construction which is made and sold by others, without leave or license, is an infringement of the rights of the Patentee.

But where a trader has registered a Trade Mark for a lamp which is not the subject-matter of a Patent, all the world may make and sell precisely the same lamp, with this restriction only—that they must not sell it under the registered Trade Mark, for this would be to represent the articles as having been made by the owner of the Trade Mark.

A Design, on the other hand, like a Patent, has reference to the specific substance or *corpus* of an article, but rather from an artistic or configurative than from a functional point of view. Thus the patented portion of the lamp might relate to a new automatic safety extinguisher, which might be made and applied and be operative in several forms, and still be within the scope of the Patent, while the Design might refer to the shape of the lamp or to the decorative stand, which could not be varied seriously from the registered design without going outside the limit of protection.

In some instances it might even happen that the improved fixed shape or configuration of an article might render it patentable as well as the subject-matter of a Design, in which case the two rights might co-exist independently of each other (see Werner v. Gamage). Such instances are not unknown, but are likely to be rare.

## Basis and Objects of Trade Mark Law.

The foundation upon which the law relating to Trade Marks and Trade Names rests is that the deception of the public by the offer for sale of goods as possessing some connection with a particular trader, which they do not in fact possess, is a wrong in respect of which the trader has a cause of action against any person who is the author of, or is responsible for, the deception.

The object or purpose of the law in protecting Trade Marks is twofold: First, it secures to him who has been instrumental in bringing

into the market a superior article of merchandise the fruit of his industry and skill; second, it protects the community from imposition, and furnishes a guarantee that an article, purchased as the manufacture or selection of one who has appropriated to his own use a certain Trade Mark, is genuine. The law thus prevents fraud upon the manufacturer, and imposition upon the public.

The accepted principles upon which the Courts now proceed in Trade Mark cases are best expressed in the following deliverance of Bacon, V.C., in Ransome v. Graham:—"A manufacturer who produces an article of merchandise which he announces as of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his 'Trade Mark.' By the law of this country (and the like law prevails in most other civilised countries) he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners."

It will be noted that the foregoing quotation speaks only of a "manufacturer" adopting a Trade Mark for the goods he has made. It must, however, be said that, although this is perhaps the most common ownership of a Trade Mark, there are many instances where the mark is adopted and applied by those who are not actual makers of the goods to which the mark is affixed, but are selectors, packers, or merchants merely.

But, apart from manufactured goods, Trade Marks might be used to distinguish substances which are natural products, such as moulders' sand, coal, mineral waters, mineral oils, fruit, and the like. Even the name of a natural product may be appropriated as a trade name to an individual if he alone has exclusive access to the natural product (Appollinaris Co. v. Norrish; Radde v. Norman).

In Trade Mark cases, the question is not whether the complainant was the original owner or proprietor of the article made by him, and upon which he now puts his Trade Mark, nor whether the article made or sold under his Trade Mark by the defendant is equal to his own in quality and value. But the Court proceeds on the ground that the complainant has a valuable interest in the goodwill of his trade or business, and, having appropriated to himself a particular Trade Mark, indicating to his customers that the article is made or sold by him or by his authority, he is entitled to protection against one who attempts to pirate upon the goodwill of his friends or customers, or the patrons of his trade or business, by using such Trade Mark without his consent or authority. It is hence settled law that the right to use a Trade Mark is not a mere personal privilege, but that, within certain limits, it is property, capable of being bought and sold, and for the invasion of which an action for damages will lie, and the exclusive use of which will be protected, when necessary, by injunction.

## Office of Trade Mark is to Indicate Trade Origin of Goods.

The office of a Trade Mark is to point out distinctively the origin or ownership of the article to which it is affixed or applied. The Trade Mark must, therefore, be distinctive in its original signification, pointing to the origin of the article, or it must have become so by association. While the Trade Mark must indicate the "true origin or ownership" of the article to which it is applied, it need not give such indication directly or by its own meaning. It is sufficient if it indicate that the ownership or origin is by association of the particular mark with the particular article. For instance, if an arbitrary or fanciful mark or device is applied as a Trade Mark to an article, there need be nothing more than this mark or device on the article. The manufacturer's or dealer's name and address may be wholly wanting, and the indication of the origin or ownership may be the consequence of such continued and uniform use of marks, devices, or, in some instances, of words, by a manufacturer or dealer, as to create, in the mind of the public, an association between the marks, devices or words on the article to which they are attached, on the one hand, and the manufacturer or dealer or places of production on the other; so that the mere marks, devices or words, which upon their face impart no reference to or connection with the manufacturer of or dealer in the article to which they are constantly affixed, nor any index to its origin, may, because of such customary use upon such article, come to indicate clearly its origin or ownership. The Trade Mark will then indicate origin or ownership wholly by association.

## Extent of Use Necessary to Identify Mark with Goods.

The association of the Trade Mark with the origin of the goods may be acquired only after long use. The effect as well as the value of the Trade Mark is the work of time and experience. It is sufficient for all purposes if, at the time when the question of the validity of the Trade Mark is raised, it is well understood by the trade that articles bearing the mark are made or sold by a particular manufacturer or vendor. The original use of the Trade Mark may have been begun and continued for any length of time without any thought or intention on the part of the proprietor of the device of its being or becoming a Trade Mark. As stated by the Supreme Court of the United States: "The ordinary Trade Mark has no necessary relation to invention or discovery. The Trade mark recognised by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident, rather than design." It is for this reason that a descriptive or geographical term may sometimes become a valid common law Trade Mark. When first employed, such term may only have been used in its primary descriptive sense, but, after long use, it may acquire a secondary or new meaning, and may come, when thus used, to designate to the mind of the purchasing

public the particular article as made or sold by a particular manufacturer or vendor, instead of indicating that the article possesses certain qualities, or is to be obtained from a particular locality.

## No Abstract Right of Property in Trade Marks.

While the exclusive right to use a Trade Mark is property, there is no abstract property right in a Trade Mark. It is property only when appropriated and used to indicate the origin or ownership of a commercial article. The Trade Mark has no separate, abstract existence, but is appurtenant to the goods designated.

Where the Trade Mark itself, in whole or in part, has been appropriated, it is not necessary to a recovery in equity to prove fraud or an inferior quality of the article of the defendant.

## Aliens' Marks Protected.

Registration of Trade Marks is granted to aliens, and the rights of aliens in their marks are protected in the English Courts as rigorously as if they belonged to British subjects.

## Statements Contained in Marks must be "Bona Fide."

It is imperative that the utmost good faith be displayed in connection with the wording used in Labels and other Trade Marks. Any misrepresentation of fact may lead to refusal of registration, or failure of proceedings taken to repress infringement or passing off.

The using of fictitious Doctors' names on Medicine Marks is the commonest form of such misrepresentation. Another common form is the employment of words or symbols indicating false places of origin or used for the purpose of suggesting that the goods are manufactured in a way other than that used in fact, or contain ingredients or possess qualities not contained in or possessed by them. When the name of an individual or firm other than that of the applicant for registration is used in a mark, evidence of authority for using it will ordinarily be called for before registration is allowed. Such words or phrases as "Registered," "To counterfeit is forgery," "Copyright," "Registered Design," or the like must not appear on the marks when submitted for registration unless the mark was previously registered in a State. But a mark when registered may have the word "Registered" printed on it.

In the case of the Leather Cloth Co. v. Am. L.C. Co., it was held that where an advertisement or Trade Mark states what is not true, it cannot be made the subject of protection in the Court. In that case the label which it was sought to protect was so framed as to lead the public to believe that certain goods were tanned, whereas they were not tanned, and were made in the United States of America, whereas they were made in England. It was held in Fuente's case that

the former fraudulent use of marks representing that certain cigars were made in Havanna, whereas they were made in Mexico, disentitled the applicant to have them registered as new marks, even though the dishonest portions of the old marks were omitted, for that would in effect have been to enable the applicant to benefit by his former fraudulent conduct. A similar decision was given in the case of Newman v. Pinto. The plaintiff was refused protection against an alleged infringement of his rights in a Trade Mark and Label used in connection with cigars because the cigar-boxes and labels conveyed a representation that the cigars were manufactured in Havanna, which was untrue. In these cases the misrepresentation seems to have been actually contained in the Trade Mark. The same reasoning would apply if the trade was a "fraudulent trade," as in Perry v. Truefitt, where the use of the Trade Name was to sell under the name of "Mexican Balm" some composition which never came from Mexico, but which was said to be composed from some wonderful herbs to be got only in Mexico. Again in the case of Pidding v. How there was evidence that the object was to persuade the public that the tea which was called "Howqua's Mixture" was an extraordinary mixture made up by some great man in China, when, in point of fact, it was made in England. (See also Bile Bean Co. v. Davidson.)

"Scandalous" designs in marks or marks the use of which would be prohibited under the Commerce Act or other law or "opposed to morality," and also deceptive marks and other marks which would be deemed unworthy of support by a Court, are unregistrable (Sec. 114).

The administration of Equity is founded on perfect truth, and when the owner of a Trade Mark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not, in his Trade Mark, or in the business connected with it, be himself guilty of any false or misleading representation; for if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses, and very justly, his right to claim the assistance of a Court of Equity. He must come there with clean hands.

Again, a Trade Mark which contains false representations, so as to deceive the public, will not be protected in equity as a valid Trade Mark, and cannot be registered as such. In short, as was said by Wallace, J., in Ginter v. Kinney Tobacco Co., no principles are better settled in the law of Trade Marks than that a generic name, or a name merely descriptive of the ingredients, quality, or characteristics of an article of trade, cannot be the subject of a Trade Mark; and that the use of a name or term which is likely to deceive the public in reference to the components or nature of the article to which it is applied will not be tolerated. But mere collateral misrepresentations do not disqualify.

## Appropriation of Known Designs for Trade Marks.

The source from which a design for a Trade Mark is obtained is not a fact bearing on the question of right to registration of it. That

right arises out of the actual user of the mark upon goods to distinguish them for trade purposes from other goods, and the ownership of a mark by one trader in connection with one class of goods will not prevent the lawful adoption of it by others for other goods. Thus, a printer's catalogue may illustrate a stock block of, for instance, a star or an anchor. A grocer may buy the catalogued block from the printer and use it to print labels to apply to flour and cocoa or other goods, and may register those labels as his Trade Mark for such goods. And if the block itself is not the subject of design registration, the grocer may make stereos or electros from it, and the printer cannot prevent him from doing so. Subsequently another grocer may see the mark and adopt it for candles, and obtain a valid registration of it for candles, notwithstanding that it is already registered for flour and cocoa. But if the second grocer applied to register the mark for self-raising flour or for chocolate, the Registrar would probably exercise his discretionary powers and object to the application on the ground that the close similarity of the goods would make it undesirable to grant separate certificates to different persons for the same mark.

## Descriptive Marks Not Registrable.

Use of the Royal Arms or the like insignia so as to suggest that business is being carried on under State authority is prohibited, and the onus of disproof put on the user, except where the same is used in fact with State authority.

The question of descriptiveness can hardly arise except in regard to Word Marks, which are at once the most valuable and the most dangerous of Trade Marks. The mark must be one which is recognizable by the trade and the consumer as definitely indicating the goods to which it is applied to the exclusion of other goods as the product of the person who uses the mark. To be distinctive, a mark must be different from other marks used upon or in connection with the same kind of goods. Any mark which describes the goods, their quality, or the purpose for which they are applied, no matter how remote the significance may be, provided there is a significance, is not registrable. The Courts have shown much caution before giving judgment in favour of a mark wherever any reasonable argument has been brought up tending to prove that it contained any character of descriptiveness or deceptiveness. (See Weingarten v. Bayer.) In determining whether a mark is distinctive, regard will be paid to the extent to which it has been used before application for registration, if the use is such as to give the apparent non-distinctive features of the mark a secondary significance or meaning in relation to the registrant's trade. In the case of marks registered in a particular colour or colours, colour effect will be considered in determining the question of distinctiveness.

## Trade Names.

A Trade or Commercial Name is a name under which a business is carried on, or by which it is designated, or the name of the place at which a business is located. In the former instance it may be the name

or names of one or more individuals, or the name of a firm, an association, or a corporation. A Trade Name should be considered and treated the same as a Trade Mark. If the name is arbitrary or fanciful, the adopter and user may acquire an exclusive right thereto, and may prohibit others from using it, even though such use is innocent or accidental, and no element of fraud is present. A great many terms used as Trade Names, however, are of such character that they cannot be exclusively appropriated, and, in seeking to protect such names, reliance must be placed on the doctrine of unfair competition. There is a great deal of confusion in the decided cases upon this branch of the subject, for the reason that courts have not always distinguished between cases involving Trade Names that can be exclusively appropriated and those in which relief, if granted at all, must be granted on the grounds of unfair competition. In other cases where injunctions have been refused it is probable that, if the cases had been presented as cases of unfair competition, relief would have been afforded. A Trade or Commercial Name differs from a Trade Mark in that it is not affixed or applied to a commercial article. In a strict sense, the term "Trade Mark" is applicable only to a mark or device that is affixed or applied to a commercial article to indicate origin or ownership. A Trade Name is not so applied, but the Courts protect it on the grounds analogous to those on which Trade Marks are protected. Where the Trade Name is one that is capable of exclusive appropriation. an injunction will be granted against an innocent or accidental use thereof by others; but where the name is merely a descriptive or geographical term, or one which others have an equal right to use, an injunction will be granted only for the purpose of preventing unfair competition in business.

Names which are merely descriptive of well-known classes of goods, or of well-known methods of transacting business, cannot be exclusively appropriated as Trade Names. Names which are thus descriptive of a class of goods cannot be exclusively appropriated by any one. The addition of the word "Company" only indicates that the parties have formed an association or partnership to deal in such goods, either to produce or to sell them.

In nearly all Trade Name cases, even more than in Trade Mark cases, elements of unfair competition are present. Usually, when a person adopts a Trade Name closely resembling that of a name already in use, it is done for the purpose of diverting a part of the first user's business or patronage. If this is so, it will usually be made apparent to the court, and the case then becomes one of unfair competition. It will then be immaterial whether the name used is capable of exclusive appropriation or not.

The right to free and unrestricted competition is freely admitted, but such competition to be legal must be honest, and the Courts will not countenance fraud or dishonesty under the guise of business competition.

## Improper Registration by Agents.

In past practice a number of cases occurred in which local representatives of or agents for foreign producing firms registered the Trade

Marks used on the goods in their own names. Registrations so effected are void. In *ex parte* Lawrence it was held that such a registration was a wrongful act on the part of the registrants, which made the entry totally void; the Court declined to order the assignment of the registration to the principals, because, being registered improperly, the registrant had no effective rights to convey—he could not assign it without the goodwill of the business, and that goodwill belonged to his principals and not to him; the entry was therefore ordered to be expunged, and the principals were left to make an application for registration *de novo* in the usual way.

Similarly, in the Appollinaris case it was held that a person who puts another's Trade Mark on the Register cannot be a person "entitled" under the Act, and that the mark of a manufacturer pure and simple cannot rightly be assumed by an importer from that manufacturer, or by a person who buys from that manufacturer, unless indeed where all the goods of the manufacturer go to that importer or that dealer.

In Harris v. Ogg (N.S.W. Law Rep.), it was held that the applicant for registration must be entitled to the mark in some way other than by mere priority of application; consequently the actual owner of an established but unregistered mark may go to the Court and procure rectification of the Register by the removal of a registration effected by a person who, though concerned in the trade, was not the actual proprietor of the Trade Mark.

To obtain valid registration an applicant need not be the actual manufacturer of the goods. A mark may be used to indicate a merchant, packer, or retailer, equally as well as a manufacturer. A manufacturer who makes goods for another person and applies to such goods a particular Trade Mark at the request of the purchaser acquires no proprietary right to such mark, which in fact belongs to and is registrable for such goods only by the person who orders the goods and directs the application of the mark to them (*re* Sykes; also Austn. W.I. Co.; Leahy v. Glover; Defries v. Helios Co.).

# Part II.—Registration of Trade Marks in the Commonwealth, Procedure, Effect of Registration, and Statutory Remedies for Infringement.

## Provisions of Commonwealth Trade Marks Act.

The operation of the common law is preserved and the Act does not affect any rights or liabilities acquired or incurred under State laws before 2nd July, 1906. From the date mentioned State laws cease to have effect; except in so far as may be required to enable the Registrar to complete pending proceedings and to govern registrations continuing to exist thereunder. An exception is made for applications which it may be found necessary to file under a State law in order to preserve rights under the International Convention.

In the New South Wales State law Trade Mark registrations had a perpetual currency; in the other States the term of registration was 14 years, before the expiration of which period the rights could be renewed by the mere payment of a fee. The Commonwealth law, however, cuts short the life of New South Wales registrations, making them operative for 14 years only from 2nd July, 1906, and in the case of marks registered in the other States, declares that the registration shall cease to be operative when the current 14 year period has expired, before which time the registration of the mark must be effected under the Commonwealth law if continued protection is sought for. No renewal fees under State Acts will be accepted.

## Commonwealth Registration of Trade Marks.

Three forms of registration are provided for by the Trade Marks Act.

(1) For marks already registered in a State or States.

(2) For marks in use in a State or States before 2nd July, 1906, but unregistered.

(3) For marks propounded as new marks, that is to say marks not already in use or registered in the States before 2nd July, 1906.

Certain marks must be registered as "Associated" or as "Series" marks. The Act also provides for the registration of "Workers'" marks, "Commonwealth" marks, and "Standardisation" marks.

Special provision is made to meet the obvious difficulty arising out of the fact that the various State laws were not uniform in respect to the requirements as to the nature of a registrable mark. It is not

every Trade Mark which is registrable. Only those marks may be put on the Commonwealth Register which fall within the terms of the Trade Marks Act.

A mark to be registrable must definitely contain one or other of the "essential particulars" enumerated in the Act, unless in the case of marks previously used or registered in the States, it is registered subject to conditions and limitations dictated by the Registrar, Law Officer, or Court.

## "Essential Particulars" of Registrable Trade Marks.

Section 16 of the Act is as follows:—

The essential particulars of a registrable trade mark shall be one or more of the following particulars:—

(*a*) A name or trading style of a person printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature or copy of a written signature of the person applying for registration thereof or some predecessor in his business; or

(*c*) A distinctive device, mark, brand, heading, label or ticket; or

(*d*) An invented word or invented words; or

(*e*) A word or words having no reference to the character or quality of the goods and not being a geographical name used or likely to be understood in a geographical sense.

Sections 17, 18 and 19 refer to the additional matters which a mark may and may not contain:—

17. The additional matter which may be added to the essential particulars of a registrable trade mark shall be:—

(*a*) Any letters, words, or figures; or

(*b*) Any combination of letters, words, or figures, or of any of them.

18. Except in the case of a Trade Mark properly registered in any State Trade Marks Act, a registrable mark must not contain—

(*a*) The words "Trade Mark," "Registered," Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," or words to the like effect; or

(*b*) A representation of the King, the Queen, or any member of the Royal Family or of the Royal Crown.

19. A registrable trade mark must not contain—

(*a*) The word "Royal" or any word, letter, or device, indicating Royal or Government patronage; or

(*b*) A representation of the Royal Arms, or of the national flag of the United Kingdom, or of the flag of the Commonwealth, or of the national arms of the United Kingdom, or of the arms or seal of the Commonwealth or any State; or

(*c*) A representation of any living person without his written consent.

**Name Marks.**—It will be observed that the name of a person or firm is not registrable alone; it is only registrable when presented in some shape which apart from the name itself introduces a distinctive character. If the name proposed for registration were not the proper name of the applicant and were the name of some other identifiable person who did not assent to the use of it, the Registrar's discretionary powers would enable him to reject the application. It is the policy of the law to refuse registration for mere surnames in association with

the names of goods, for instance, "Brown's Flour." Marks of that kind are of particular value in trade, but practical experience has proven the unwisdom of securing a right to individuals to appropriate a surname in this way; for other persons with the same name would thereby be excluded from trading in the same goods under their name. It remains to be pointed out, however, that the remedy by proceedings for "passing off" would still be effective to protect the first user where the name used had come to bear a secondary signification. While the Court would not prevent a rival trader from legitimately using his own name even if it were the same name as that of a prior successful trader, it would still impose on him the obligation of using his own name in such a way as to clearly distinguish his goods from the goods of the prior trader. A name printed in type which is in ordinary use would not be registrable.

**Signatures.**—It is clear that a signature mark is a dangerous mark, except in some very special class of case, for the registrant under this sub-section could not complain of another trader using his signature as a Trade Mark. Where the names happen to be identical, or nearly so, the distinctiveness of the signatures as against one another would in some cases be reduced almost to vanishing point, and the registration would be next to useless.

**Devices.**—A Trade Mark which has a device as its central figure is an advantageous Trade Mark in that it appeals to the eye quite apart from any wording which is used in connection with it. The chief objection is the difficulty of choosing a mark sufficiently simple and striking to fix itself in the memory and to suggest some name by which it can be indicated, whilst securing at the same time sufficient difference from other devices or words or names suggesting them used in the same line of trade to ensure distinctiveness.

A portrait is a registrable device, provided that it is not a portrait of a person identified with the trade, so that traders generally could claim to be fairly entitled to use it. (See Anderson's case, *re* Liebig's Extract.) Where, however, the name or portrait of a person believed by the Registrar to be living is used, registration will be refused until the consent of such person to the use of his name or portrait be obtained. Portraits are not very valuable as Trade Marks because infringement can only be proved against goods on which not merely another portrait, but necessarily a similar portrait is used.

A representation of the goods to which the mark is to be applied is not a registrable "device." Thus the picture of a telephone would not be a registrable mark in respect to telephones, though it might be a good mark in respect to flour. While that is so, it is conceivable that it would be possible to design a registrable device involving a representation of the article to which it is applied. For instance, a mark consisting of a representation of bags of flour arranged in the form of a star or triangle might be a registrable mark for flour. The rule is that the mark must not be such a one that its registration would restrict the liberty of rival traders to use in any reasonable manner representations of articles sold by them for the purpose of describing or indicating such articles.

Devices or words of a national character, such as the Royal Arms, or Crown, or national or State Arms, or flags or seals or public armorial decorations, bearings or insignia, or the words "Royal" or "Government" or words indicating Royal or Government patronage, will not be registered.

**Marks and Brands.**—The terms mark and brand have never been adequately defined, except to this extent, that they are deemed to include only something applied by marking or branding and not falling within the other definitions. A word must be propounded for registration as a word and not as a brand. (See Leonard & Ellis' case; Holt's case.) Letters or figures cannot be brought within the scope of the definitions by calling them "marks and brands." Initials are not registrable, and it is doubtful whether a monogram is registrable. (Lucke v. Webster.)

**Headings.**—Heading means a pattern of marking such as is woven at the end of a piece of cloth. Section 21 is important in relation to "Heading" marks which consist essentially in colour schemes. Under that section a registered mark may be limited to a particular colour or colours, so that it is possible that precisely the same mark in outline might be registrable by different persons, provided each of them adopted a different colour scheme, so that the marks when presented would in each case be different in substance and in general appearance, though identical in outline. In ordinary cases of name devices, &c., a mark is usually registered without limitation to colour, and the registration is then effective for the mark, quite irrespectively of the colour in which it is used; but registration may be obtained for a particular colour or colours, and infringement will then only occur when the registered colours are used.

**Labels and Tickets.**—A label or ticket consists of a number of words, or words and devices, or a device alone printed on a piece of paper to be stuck upon or attached to the goods or their envelope. A mark otherwise unregistrable will not become registrable merely because it is printed on a paper slip and called a label. (See Great Tower Street Tea Co. v. Smith.) The case would not be improved by using a conventional border or other non-distinctive matter. The name of a firm printed in common letters upon an ordinary label would not make a registrable label. (Birmingham Vinegar Co. T. Mark.)

**An Invented Word or Words.**—An invented word is a word newly coined and not directly descriptive of the goods to which it is applied. It is no objection that it may be traced to a foreign source or that it contains a covert allusion to the character or quality of the goods—it need not be a mere euphonious association of letters wholly meaningless. "Savonal" for soap, "Tachytype" for type-composing machines, "Tabloid" for tablets of chemical products have been held good marks. But mere dictionary words compounded, contorted, misspelt or used with prefixes or suffixes are not invented words. "Asorbine," "Cheapandgood," "Phiteesi," "Uneeda" (You-need-a), "Pirle" (Pearl) have all been decided against. A word built up on correct etymological principles, whose clearly-ascertainable mean-

ing is descriptive of the nature or qualities of the goods to which it is applied, would probably not be registrable.

**Non-Descriptive Non-Geographical Words.**—This definition provides for known words or expressions arbitrarily chosen from the English or from foreign languages. Words savouring of advertisement, recommendation or description or being a mere surname are not registrable. The purpose of the limitations is to preserve the right of the public to use known words or literal variations of them in their ordinary sense, and the Office will jealously guard the public right in this regard. The prohibition on the ground of geographical character only applies when the use of a geographical name would be understood in a geographical sense, but this qualification should be availed of with caution, as it cannot always be said definitely whether a geographical name has or has not a geographical significance. It is, however, not clear whether the test must be sought in the name itself or having regard to the nature of the goods on which it is used. In the former case the excluding qualification would only apply to rarely-heard-of geographical names, and no names likely to be found in a common atlas would be registrable; in the latter case a name that would be registrable for one class of goods would not be registrable for another. There are of course many geographical names which are common in other connections, and the qualification would apply to these and leave them open for registration if they are not so used as to suggest a geographical interpretation. It is submitted that the former reading is the correct one, and that quite irrespective of the nature of the goods a word mark will be tested for geographical significance, and registration refused in the case of known geographical terms except where the accepted primary signification is other than geographical. (See Magnolia T.-M. case; Apollinaris T.M.) But where the word is the name of the place of manufacture of the goods, then, no matter how little known the place is, the word has a geographical significance. Whilst the names that are registrable are defined by sub-section (*a*), there remain another class of names which come within the present sub-section—that is, the names of imaginary or mythical personages such as "Trilby" (Holt's case), "Hamlet," "Jupiter" and the like who are not "individuals" in the sense of sub-section (*a*). Such names are as properly registrable as other known words having no meaning in relation to the goods to which they are applied, for instance "Monkey," or "Ivy," or "Red Cap" for soap.

A word alone is not a Trade Mark when it is applied to designate, not the article of a particular maker or seller, but the kind or description of thing which is being sold. And it was held by the Court of New South Wales that, where a word had been used by the inventor in connection with a particular class of goods, but had not been registered as a Trade Mark, and it was made use of by another, not with any fraudulent intention of counterfeiting the goods of the inventor, but to denote the quality and character of the article sold, and the word had come to be so understood, it had become *publici juris*, and could not thereafter be registered as a Trade Mark. And when

an unpatented medicinal preparation had come to be popularly known by the name of the person, another person lawfully engaging in the manufacture of it has no right to appropriate that name to his own exclusive use as a proprietary Trade Mark or Trade Name.

It will be clear, therefore, that when a manufacturer has invented a new name, consisting either of a new word, or a word or words in common use, which he has applied for the time to his own manufacture or to an article manufactured by him, to distinguish it from those manufactured and sold by others, and the name thus adopted is not generic or descriptive of the article, its qualities, ingredients or characteristics, but is arbitrary or fanciful, and is not used merely to denote grade or quality, he is entitled to be protected in the use of that name, notwithstanding that it has become so generally known that it has been adopted by the public as the ordinary appellation of the article.

**Additional Features of Marks.**—So long as a mark contains one of the "essential particulars" mentioned in section 16 it is registrable whether it contains additional matter or not; and in registering it the essential particulars upon which the registrant intends to rely must be stated. The correct statement of the essential particulars is a matter of great importance because it is the basis of the registration. The mark may contain an unlimited quantity of additional matter in the shape of letters, words or figures. When the mark contains in addition to its distinctive essential particulars parts not forming the essential particulars of other marks owned by the same proprietor, or contains common trade matter or other non-distinctive matter, the applicant for registration may be obliged to "disclaim" the exclusive right to such additional matter or insert in his application a disclaimer adequately defining the rights he claims. The name or address of an applicant or of his predecessor in business need not be disclaimed. The making of a disclaimer will not prejudice any rights in case of proceedings for "passing off."

**"Disclaimers."**—Where a mark, or matter contained in a mark, is used contemporaneously and *bonâ fide* by three or more persons in any one State, such mark or matter is deemed common property and is not registrable; and if it appears in a mark otherwise registrable, disclaimer will be called for if application for registration thereof is made. Similarly non-distinctive matter will be subject to disclaimer at the Registrar's discretion, and such other matter (not being the subject to separate registration by same applicant) as the mark contains in addition to its essential particulars.

**Associated Marks.**—Where the same proprietor applies to register a second or subsequent mark similar to one already registered by him, the Registrar may decline to register it as an independent mark on the ground that if it were assigned whilst the earlier registration were retained, trade confusion would arise as between the original proprietor and the assignee. In that case, registration of the subsequent marks will be effected as "Associated" marks. That is to say, the related marks will be bunched on the register so that they will not be assignable separately; otherwise the registrations stand quite indepen-

dently, as if registrations of distinct marks (Sec. 29). Similarly, where a proprietor desires registration of two or more "series" marks, that is, marks substantially identical in design but differing in regard to names of goods or other descriptive matter contained thereon, such marks are registrable only in the "associated" form (Sec. 31). The object of the provision of the Act in connection with disclaimers and the bunching of related marks is to make each registration stand quite alone and to show on its face precisely what it covers. The Registrar's duty is to guard against public confusion in the case of marks belonging to the same proprietor as well as in the case of marks belonging to different proprietors; in the first case he will require that similar marks be bunched and registered as "Associated" marks, which, as explained elsewhere, can only be assigned in the bunch; and in the second case he will refuse any application for the registration of a mark deceptively similar to any mark already registered by other proprietors.

## Commonwealth Registration of Trade Marks which were already registered or in use in the States before 2nd July, 1906.

In the case of Trade Marks properly registered under one or more of the old State laws, registration may be effected notwithstanding that the mark does not contain any of the essential particulars required in the case of new marks. Similarly, marks in use before 2nd July, 1906, in one or more of the States and not containing such essential particulars may also be registered, provided they would have been registrable under the State Law (Secs. 8, 9). This provision will be operative chiefly in the case of N.S.W. marks, because the registration laws of the other States, generally speaking, contained more restrictive provisions as to registrable marks than the new Commonwealth Act. It is intended also to continue the policy of the State laws, which (following on the lines of the English Acts of 1875-6) acknowledge the rights to registration of owners of marks in use before those laws were passed.

When these old State marks do in fact contain the prescribed essential particulars they would be registrable in any event; but usually it will be advantageous to propound them for registration as old marks to take advantage of the improved status thus secured in the event of opposition or other proceedings arising. When, however, they do not contain the prescribed essential particulars they are at a disadvantage, for, although they are registrable, the Registrar may make the registration "subject to such conditions and limitations as to mode or place of user" as he thinks fit. Even where an old State mark, whether registered or not under the State law, and even if registrable as a new mark, is submitted for registration as an old mark, and it appears that the same or nearly identical mark is owned or registered in any part of the Commonwealth by another proprietor, the Registrar may in like manner impose conditions and limitations as to mode or place of user to preserve the rights of each proprietor.

It will be observed therefore by proprietors who hold State registrations for marks not containing the essential particulars (see S. 16) called for in the case of new marks, that they can only obtain Commonwealth registration on the Registrar's terms, and as the State Certificate is cancelled upon the issue of a Commonwealth Certificate, they may in some cases be well advised to rest on their existing registrations as long as those registrations will continue to hold good. There may be special reasons for this in particular cases, as where a rival trader claims a similar mark, for, although such rival trader

has no State registration to conflict with that held by the applicant, it would still seem the Registrar has power to impose conditions and limitations in favour of such rival trader, qualifying any registration he may allow the applicant. And it should be observed that even where the old mark does contain the essential particulars which would qualify it for registration as a new mark, the Registrar has still the power to qualify the registration "with such conditions and limitations as he thinks fit to impose to preserve the rights of each proprietor." In the case of marks propounded as new marks the Registrar has power (Secs. 34, 43) to qualify a registration with "conditions" and to require "modifications" of a mark either on his own initiative or in determining opposition proceedings; and of course the Law Officer and the Court have in all cases similar powers of appeal.

There are many cases in which these provisions will operate in practise. Frequently similar marks are in use by different firms in different States, whose respective businesses are practically confined to their own States. No difficulty arose in the majority of those cases whilst States registrations were independent. Now, however, when one certificate covers all the States, the case is different, for account must be taken of all interests thus brought into direct conflict. In such cases the proprietor who secures an unconditional registration before his inter-state rival appears on the scene will have an advantageous position, for his rival will then be forced to go to the Court (Sec. 71) to procure the insertion on the register of "any exception or limitation affecting the registration of the Trade Mark," and the registrant will then lose only just so much as justice demands, and will not have to take something less on the basis of a compromise dictated by the Registrar when two interfering claims come before him in application proceedings. It is anticipated that the Registrar will be called upon to deal with many conflicting claims under these clauses between rival traders in New South Wales and Victoria, and New South Wales and South Australia. In some of these cases the difficulty is greater than would appear at first sight, because the conflicting claims overlap, and cannot be pacified by alloting State territorial limits to one and the other respectively. Thus, for instance, the Broken Hill district, which is New South Wales territory, gets most of its supplies from South Australia, and some of the marks used, which are registered by Adelaide firms in South Australia, are very similar to marks used on other New South Wales trade generally by Sydney merchants, who have obtained New South Wales registrations for them.

Under these clauses (8 and 9) another provision is made to the effect that when an old mark is propounded for registration and it is found that it is "common to trade" in a State other than that in which user or State registration is claimed, any Certificate issued shall not confer exclusive rights in the State in which the mark is in fact common to the trade.

Under some circumstances user of one mark may be taken to be equivalent to use of other marks bunched with it as "Associated" marks (Sec. 30). In those cases where the form of an old mark has been modified without altering its general character, the altered mark

may be submitted for registration as an old mark to continue the right established by user of the original mark of which it is a modification.

When an application refers to a mark already registered or submitted for registration in one or more of the States, particulars of the official action on the State's applications must be funished under Statutory Declaration, and facsimiles of the mark as registered in the States must be supplied.

In all cases 14 copies of the mark proposed for registration must be supplied, 9 of them attached to the prescribed forms.

All applications, Documents and Notices may be signed and all Hearings attended and other proceedings conducted by a Registered Trade Marks Attorney on behalf of his principal.

## Effect of Registration.

The object of the Act is not to create new rights but to regulate the use of and the means of protecting Trade Marks *other than Common Law marks.* It provides, as did the old State laws, for the acquisition of title to Trade Marks by registration, though it is to be remarked that the Act does not declare definitely that mere registration shall be equivalent to user. In the absence of special legislation, a Trade Mark would not be entitled to consideration at the hands of a Court unless on the basis of user. Under the Act either a Trade Mark which is in use, or a new mark, may be registered if it is a mark which comes within the Act's definition of a registrable mark. The Act also regulates procedure in infringement actions, simplifying it by making the fact of registration *primâ facie* evidence of title, and, in some instances, conclusive proof of it. In the case of registrable marks the Act constitutes registration, generally speaking, the condition to be performed precedent to the beginning of an action for infringement, but a registrable mark may without registration be sued on as a common-law mark, and the ordinary common-law remedies obtained; but without registration an action for infringement cannot be taken, nor can the special remedies authorised by the Act be obtained. In the case of marks registered under the old State laws, however, actions for infringement may be taken and statutory remedies obtained under those laws so long as the State registrations remain effective. The nature of the particular kinds of marks which are registrable under the Act are defined in it, and consequently those marks only are capable of receiving the protection which the Act affords. Registration gives an independent title apart from the rights acquired by user, so that a registrant need only rely on his title by user if the property in the registration is questioned, or if within five years conflicting rights arise for determination of the Court. Registration confers no rights except in regard to the goods for which a mark is registered, and of course if there is any limitation imposed by the Registrar in effecting registration that also will control the extent of the nature of the right conferred by registration. If a mark is actually used for one description of goods only, although registered for others also, the exclusive rights conferred by the Act do not extend to the latter. Thus, where the registrant of a mark for "Unwrought

and partly wrought metals used in manufacture" only used the mark upon sheet-iron goods, to which line his business is confined, an order was made for the rectification of the Register by confining the statement of goods to sheet-iron. If the register shows that the registration was five years old at the date when it is put in evidence, it will be conclusive evidence of the validity of the registration so long as the registration stands, but this is conditional upon proof that the registrant or his predecessor in title has continuously used the mark during that term to a substantial extent and without any actual interruption for an aggregate of one year. Even after five years, however, the registration may be attacked upon application to the Court for an order for expunging or varying it. Whilst, therefore, in an action for infringement a registration of five years' standing has a title which cannot be objected to, it is still settled law that an application may be made to the Court to rectify the register, if in fact the registration is not entitled to remain on the register.

## Term of Registration.

When a Trade Mark has been registered it is protected for 14 years. At the end of that time, and so on at the end of every 14 years, the payment of a fee ensures another 14 years' protection. Three months' grace is allowed, subject to payment of a fine. When the protection has elapsed by failure to make the renewal payment, the mark is removed from the register, but under certain circumstances the Registrar may for the term of 1 year still continue to regard the registration as a current one for the purpose of quoting it against new applications for registration.

## Registration Ineffective Without User.

Although the actual use of a mark is not a condition precedent to registration, nevertheless an applicant must at least intend to use any mark which he registers on the goods for which he registers it, and if he registers without such an intention, the mark will be removed from the Register. The intention must be a definite and present intention to deal in the goods and apply the mark to them, and not a mere general intention of extending business at some future time, if it should be thought desirable to use the mark on other lines (see *Batts* T.M.). If a mark is registered merely for the purpose of preventing other traders from using it, it will be removed (see *Apollinaris* case).

## Proceedings on Application to Register Trade Marks.

Trade Marks must be registered in respect of the particular goods or classes of goods on which they are used. The use of a Trade Mark by one manufacturer or vendor will not ordinarily prevent another from adopting the same Trade Mark for a different article. He cannot prevent its use when the use is entirely innocent, and represents nothing

in regard to the plaintiff's connection with the goods, and does not impose on the public. A separate registration must be effected for every class. In the case of marks used on a number of lines of different goods a corresponding number of separate registrations is called for. In some cases even similar goods come under separate classes. Thus, Soap comes under five classes, viz.:—(2) dog soap and disinfecting soap; (3) medicated, for human use; (47) common; (48) perfumed for shaving; (50) silversmiths' soap. Again, Wire falls under Class 5, Wire fencing and netting and Wire rope under Class 13, and Wire mattresses under Class 41. Again, Metal washers are under Class 13, Leather washers Class 37, and Rubber washers Class 40.

The classification is as follows:—

1. Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.
2. Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.
3. Chemical substances prepared for use in medicine and pharmacy.
4. Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.
5. Unwrought and partly wrought metals used in manufactures.
6. Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.
7. Agricultural and horticultural machinery, and parts of such machinery.
8. Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.
9. Musical instruments.
10. Horological instruments.
11. Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.
12. Cutlery and edge tools.
13. Metal goods not included in other classes.
14. Goods of precious metals (including aluminium, nickel, Britannia metal, etc.) and jewellery, and imitations of such goods and jewellery.
15. Glass.
16. Porcelain and earthenware.
17. Manufactures from mineral and other substances for building or decoration.
18. Engineering, architectural, and building contrivances.
19. Arms, ammunition, and stores not included in Class 20.
20. Explosive substances.
21. Naval architectural contrivances and naval equipments not included in Classes 19 and 20.
22. Carriages.
23. (*a*) Sewing cotton; (*b*) Cotton yarn.
24. Cotton piece goods of all kinds.
25. Cotton goods not included in Classes 23, 24, or 38.
26. Linen and hemp yarn and thread.
27. Linen and hemp piece goods.
28. Linen and hemp goods not included in Classes 26, 27, and 50.
29. Jute yarns and tissues, and other articles made of jute not included in Class 50.
30. Silk, spun, thrown, or sewing.
31. Silk piece goods.
32. Other silk goods not included in Classes 30 and 31.
33. Yarns of wool, worsted, or hair.
34. Cloths and stuffs of wool, worsted or hair.
35. Woollen and worsted and hair goods not included in Classes 33 and 34.
36. Carpets, floor-cloth, and oil-cloth.
37. Leather, skins unwrought and wrought, and articles made of leather not included in other classes.

38. Articles of clothing.
39. Paper (except paperhangings), stationery, and book-binding.
40. Goods manufactured from india-rubber and gutta-percha not included in other classes.
41. Furniture and upholstery.
42. Substances used as food, or as ingredients in food.
43. Fermented liquors and spirits.
44. Mineral and ærated waters, natural and artificial, including ginger-beer.
45. Tobacco, whether manufactured or unmanufactured.
46. Seeds for agricultural and horticultural purposes.
47. Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.
48. Perfumery, including toilet articles, preparations for the teeth and hair, and perfumed soap.
49. Games of all kinds and sporting articles, not included in other classes.
50. Miscellaneous:—
    (1) Goods manufactured from ivory, bone or wood, not included in other classes or sub-classes.
    (2) Goods manufactured from straw or grass not included in other classes.
    (3) Goods manufactured from animal and vegetable substances, not included in other classes or sub-classes.
    (4) Tobacco pipes.
    (5) Umbrellas, walking sticks, brushes, and combs.
    (6) Furniture cream, plate powder.
    (7) Tarpaulins, tents, rick-cloths, rope, twine.
    (8) Buttons of all kinds, other than of precious metal or imitations thereof.
    (9) Packing and hose of all kinds.
    (10) Goods not included in the foregoing classes.

[NOTE.—Each sub-class in Class 50 is deemed to be a separate class. The Registrar determines the class in case of doubt, and where goods are made of mixed materials.]*

Applications for registration are examined on three points, viz.:—

1. Whether the mark is one that is registrable under the Act;

2. Whether it is deceptively similar to any mark previously registered in the Commonwealth or in a State;

3. Whether it contains matter the common property of the trade.

Upon the Examiner's Report the Registrar determines whether he will accept the application, with or without modification, or with or without conditions, or whether he will refuse it. He gives notice to the applicant accordingly, and in case of objection gives the applicant 14 days to elect whether he desires the Registrar to hear the case. If the applicant demands a hearing, a date is fixed and he receives 10 days' notice. From any conditional acceptance there is a right of appeal to the Law Officer, and from the decision of the Law Officer there is an appeal to the High Court or to the Supreme Court. The applicant may, however, appeal direct to the Court.

The Rules contain elaborate provision for the procedure before the Registrar, Law Officer and Court.

The procedure before the Law Officer and the Court is of a technical character, and need not be detailed here.

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* At the date of issue of this book, the classification here printed had been provisionally adopted; but a proposal to adopt another scheme was under consideration.

After acceptance, the application is advertised in the Official Journal. A line block of the mark must be supplied by the applicant for this purpose. Applications not completed within one year and 14 days of filing, owing to default of the applicant in observing any provision of the Act or Rules, or decision thereunder, become void, unless in special cases in which the Registrar is empowered to grant an enlargement of time.

After advertisement, applications are held for 3 months, during which time proceedings may be commenced by anyone to oppose the issue of a certificate. The 3 months' period may be enlarged upon special application made for the purpose before its termination. These proceedings are commenced by the filing of a Notice of Opposition stating the grounds of objection in a prescribed form.

If a Notice of Opposition be filed, the applicant is allowed 3 months (of which time an enlargement can be obtained) to file a "Counterstatement" embodying the grounds relied on in support of the application; and if no counterstatement is filed the application lapses without liability for costs. If, however, a counterstatement is filed, the applicant is liable for costs in the event of the opposition succeeding. Similarly, the opponent may have costs awarded against him in the event of the opposition failing.

After the filing of a counterstatement by the applicant, the opponent has one month to file evidence on Statutory Declaration in support of the opposition, and subsequently the applicant has one month to file similar Declarations answering; then the opponent has 14 days for reply. For the filing of any further evidence, special leave or the consent of the opposite party must be obtained on either side. Duplicates of all evidence must be served on the opposite side. Failure to file evidence entails abandonment of an opposition; and it entails abandonment of the application unless the applicant elects not to file evidence and serves notice on the Registrar that he will rely on the documents filed with the application.

When the evidence is complete, the Registrar appoints a day for hearing of the case, and the parties must give the prescribed notice of intention to appear, for otherwise they will not be entitled to be heard.

Before definitely exercising any discretionary power adversely upon an application the Registrar will, if requested by the applicant within 1 month of his receiving notice in the matter, give the applicant an opportunity of attending a hearing, and if the applicant does not then formally intimate that he will attend, the application will be regarded as abandoned.

## Anticipation by Prior Registration.

**Anticipation by Prior Registrations.**—No mark will be registered which is the same as or deceptively similar to a mark already registered. When it is found that an earlier registration stands in the way of an application, the applicant must go to the Court to have the conflicting registration removed, for so long as it is on the Register the Registrar must respect it. (Sec. 25.) In cases of *bonâ fide* concurrent use, corresponding registrations may be granted to two or

more separate proprietors subject to conditions and limitations dictated by the Registrar or on appeal from him. It would appear probable, however, that this can only be done when the interfering applications are both before the Registrar at the one time; for otherwise he is bound by the existing registrations and cannot issue a certificate in derogation of an existing one except by order of the Supreme Court. A registration is *prima facie* evidence of the right of the registrant to the exclusive use of the registered mark, and of the validity of the registration thereof. (Sec. 50.) The peremptory necessity of effecting registration without delay will be quite apparent to Trade Mark proprietors upon consideration of the effect of these clauses.

The Supreme Court only has power to order the registration of a mark to override an existing registration. Once a registration is on the books, it binds the Registrar. Where rival applicants claim the same or similar mark, the Registrar may require the submission of their claims to the Court for determination before he grants registration, but where the case appears to be one of honest concurrent user, the Registrar may exercise his discretion and register the mark for both applicants (but presumably only when both applicants are before him at one time, and not when a Certificate has already been issued as one of them) subject to such conditions and limitations as he may think fit to impose. Upon registration being effected, the date of application shall be deemed to be the date of registration.

## Attendance of Witnesses, &c.

In all proceedings the Registrar may summon and swear witnesses, order the production of documents and award costs as a Court. He has power to inflict a fine of £50 for disobedience. A penalty of 3 years' imprisonment is prescribed for the making of any wilful false statement or representation in any proceedings before the Registrar. There is a similar penalty for falsifying the Register or copies therefrom.

## Cancellation and Alteration of Registration.

The Court may also, at the instance of the Registrar or of any person aggrieved by an entry, order the rectification of the Register by the variation or erasure of the entry complained of. The Court may cancel the registration of any mark which has fallen into disuse for 3 years or over and has not been in use for 6 months prior to the cancellation proceedings.

The Registrar has power also to correct or alter the names and description of registrants, to enter disclaimers or memoranda relating to registered marks, and to cancel registrations on request of the registrants. For making any alteration in the substance of a registered mark, the leave of the Court must be obtained.

## Assignment of Trade Marks.

Except in the case of "Workers," "Commonwealth," and "Standardisation" marks, registered Trade Marks are only assignable in

connection with the goodwill in the goods on which they are used. Where the goodwill is divided, as in the case of dissolution of partnership, the registered Trade Marks (other than "associated" marks, which must be kept bunched) may be divided and apportioned among the business successors, subject to such conditions as the Registrar may dictate to conserve public interests.

The Registrar has the power to enter notice in the Register of Assignments of registered Trade Marks; but he is prohibited from receiving or putting on the Register notice of any trust, expressed, implied or constructive.

There is no such thing as licensing another person to use one's Trade Mark. If the owner of a mark permits it to be used in connection with the goods of other traders he loses his claim to it. (*Wood v. Lambert and Butler*).

## Prohibition Against Infringement.

It is an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiff, and it makes no difference whether the representation is effected by direct statements, or by using some of the badges colourably resembling these, in connection with goods of the same kind, not being the goods of the plaintiff, in such manner as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff. But, except in a very extreme case, this rule has never been applied so as to prevent the defendant honestly trading under his own name, or under the names of the members of his firm, or honestly describing his goods, and their place of origin, manner of manufacture, and other characteristics, in the ordinary terms current in his trade.

The question whether the use of particular words or badges is calculated to pass off the defendant's goods as those of the plaintiff, or is merely honestly descriptive, is often one of difficulty, but it is, in substance, a question of fact.

The principle of law may be very plainly stated that nobody has any right to represent his goods as the goods of somebody else. How far the use of particular words, signs, or pictures, does or does not come up to the proposition enunciated in each particular case must always be a question of evidence, and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact, the legal consequence appears to follow.

## "Passing Off": The Common Law Remedy.

**The Common Law** action to restrain the defendant from passing off his goods as the goods of the plaintiff, is obviously the generalized form of the action to restrain the infringement of a Trade Mark; and the old principles from which the latter action grew up are still recognized and put into force by the Courts. **The Statutory** action for infringement has been specialised, and the proof of the plaintiff's case in it greatly facilitated and simplified by the registration of Trade Marks

and the provisions of the Acts; but the plaintiff's Trade Mark, although the most important, is only one of the badges by which his trade or his goods are, or may be, identified with him; and it is equally a wrong to imitate or copy any of the others—his trade-name or the get-up of his goods, for instance—so as to damage his trade by passing off other goods as his, or by leading his customers to suppose that there is a connection between such other goods and his business, which does not in fact exist.

Passing off cases are usually cases of deliberate and intentional misrepresentation, and they have been treated in many reported judgments even in recent cases, in which the attention of the Court was not directed to the point, as though fraud were a necessary element of the right of action; but it is well that this is not the case. In an action to restrain passing off, proof that the defendant intended to deceive, if his conduct is shown to be calculated to pass off his goods as those of the plaintiff, or to cause them to be so passed off, is no more necessary than in an action for infringement. And if it were necessary, it would be sufficient evidence of fraud to show that the defendant continued, or sought to continue, to use the deceptive badges or descriptions, after the danger of mistake arising from their use had been brought to his notice. For it has never been held that innocent inception is a defence.

In the leading English case of Reddaway v. Banham, it appeared that the plaintiffs had long made and sold "Camel-Hair Belting." The defendant also sold "Camel-Hair Belting." Both beltings were really made of camel-hair; but it was proved that in the trade "Camel-Hair Belting" meant camel-hair belting of the plaintiff's manufacture, and that the defendant's goods were, in fact, sold for the plaintiff's. The Court of Appeal held that the plaintiffs were not entitled to an injunction, but the House of Lords took a different view. Lord Herschel said: "What right, it was asked, can an individual have to restrain another from using a common English word because he has chosen to employ it as his Trade Mark? I answer, he has no such right; but he has a right to insist that it shall not be used without explanation or qualification, if such a use would be an instrument of fraud. Who would suffer injury by such a conclusion, or would be the worse if the defendant is thus restrained? It has been shown that the public have not needed the word 'Camel-Hair' to describe a particular kind of belting,—that the words have never been used in the trade in that sense. Can it be said that the description 'Camel-Hair Belting,' as used by Banham, is the simple truth? I will not call it an abuse of language to say so, but certainly it is not altogether a happy expression. The whole merit of that description—its one virtue for Banham's purposes—lies in its duplicity. It means two things. At Banham's works, where it cannot read Reddaway's belting, it may be construed to mean belting made of camel's hair. Abroad, to the German manufacturer, to the Bombay mill-owner, to the up-country native, it must mean Reddaway's belting; it can mean nothing else."

In the Birmingham V.B. case the mark was of this kind, and it had been registered. The Court ordered the rectification of the Register by the removal of the registration, but sustained the action for pass-

ing off; thus the common law Trade Mark rights were confirmed by the Court, but the Statutory claim on the basis of the registration was rejected because the mark did not conform with the requirements demanded by the Act to make the mark registrable.

A plaintiff may, therefore, fail to make out a case of statutory infringement of Trade Mark rights because he cannot prove his title to the Trade Mark, or to its registration, or because he fails to prove that its registration extends to the goods or to all the goods in question, or because the registration is ordered to be annulled; but may yet show that by imitating the mark claimed as a Trade Mark, or otherwise, the defendant has done what is calculated to "pass off" his goods as those of the plaintiff. It follows that a case of "passing-off" is generally added as a second string to an action for infringement, and is frequently successful where the Trade Mark action proper breaks down.

## Statutory Remedies for Infringement of Registered Trade Mark Rights.

Where marks not capable of registration are used, the proprietor may have a remedy in an action for "passing off," but he cannot have a remedy for "infringement of Trade Mark," and he is thereby placed at a serious disadvantage. As is pointed out elsewhere, the evidence which is required to sustain a "passing off" action is not always readily obtainable, whereas in the case of a registered Trade Mark it is sufficient to satisfy the Court that the offending party is using a mark colourably similar or deceptively similar to the registered mark, whether or not deception has actually occurred.

Section 53 of the Trade Marks Act enacts:—

> The rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark, or so nearly resembling it as to be likely to deceive.
>
> In an action for the infringement of a trade mark, the Court, in trying the question of infringement, shall admit evidence of the usages of the trade in respect to the get-up of those goods and of any trade marks or get-up legitimately used in respect of them by other persons.

Secs. 86 to 92 contain provisions on the lines of the Imperial Merchandise Act, which make false marking a criminal offence. For forging registered marks or falsely applying a registered mark, or being concerned in making or disposing of blocks or other means for forging registered marks, a penalty of 3 years' imprisonment is prescribed. A person who sells or exposes for sale or imports goods falsely marked with a registered mark, and who fails to prove innocence of intention to defraud, is liable to a fine of £100.

But, although he may have had no intent to defraud, a defendant is not on that account held to have acted "innocently." As Lord Coleridge said in Wood v. Burgess, "An intent to defraud the purchaser is not a necessary ingredient of the offence charged." Thus a mineral-water manufacturer who fills bottles bearing another manufacturer's name moulded thereon is not held to have acted "inno-

cently," although he may have had no intention to pass off the contents of the bottles as other than his own manufacture, or although he places his own label on the bottles. The cases dealing with the interpretation of the term "innocently" under the Statute are fully discussed in the Irish case of Thwaites v. McEvilly, in which the defendant had used his own paper labels on bottles on which the plaintiff's mark was blown.

Any person concerned directly or indirectly in the commission of any offence against the Act, whether the act be committed in Australia or abroad, is liable to a fine of £100.

When goods are imported having applied to them any forgery of a registered Trade Mark or having a registered mark falsely applied to them, or when goods produced abroad are imported bearing the *bonâ fide* registered Trade Mark of an Australian trader without a definite indication thereon of the country of origin, they may be seized by the Customs authorities and forfeited. When, however, it is determined that such contravention of the Act has not occurred either knowingly or negligently, the forfeiture may be waived, but security must be given that the improper marks will be removed or the goods exported forthwith.

The Collector of Customs is empowered to require that security shall be given by any person who requests that these provisions be put in operation for his protection; but the Collector may act on his own initiative without any request from the registered owner of the Trade Mark.

Forgery of a registered Trade Mark is defined to consist in the making of any mark the same as or deceptively similar to a registered Trade Mark, or in the altering or otherwise falsifying of any *bonâ fide* registered mark, and a mark is deemed to be applied whether used on goods themselves or on their packages or anything connected with them, or otherwise used so as to suggest that it refers to, describes or designates the goods.

Falsely applying consists in the using of a mark without the assent of the proprietor of same.

The law prohibiting false marking and requiring correct and sufficient marking of goods for import and export purposes, otherwise than in relation to the protection of registered Trade Mark interests, is contained in the Commerce Act: but that Act also incidentally protects registered Trade Mark interests in certain respects. Its definition of "Trade description" includes any description, statement, indication or suggestion, direct or indirect, as to the manufacturer, selector, packer or preparer of goods for market; or as to the mode of manufacturing, producing, selecting, packing or otherwise preparing the goods; or as to the material or ingredients of which the goods are composed or from which they are derived; or as to the goods being the subject of an existing patent, privilege, or copyright. As a registered Trade Mark may quite possibly indicate or suggest any one or more of these things, any infringing mark conveying a like indication or suggestion would be a false trade description. and the goods would be liable to forfeiture, and the importer or exporter thereof further liable to a fine of £100.

If a person adopts and uses a Trade Mark and does not register it, it does not necessarily follow that by describing it as his Trade Mark he is making a misrepresentation, and that is so even where the mark is a registrable one. In that case, however, as has been already pointed out, he could not sue for infringement without registering it.

Section 112 provides penalties for the using of the word "registered" on a mark or for otherwise misrepresenting it to be registered when, as a matter of fact, it is not registered under the Commonwealth Act. It would hardly be probable, however, that proceedings would be taken when a mark indicated as "registered" is really registered under the old States Law.

It is doubtful whether a defendant, prosecuted under the Merchandise Marks Act, can avail himself of the privilege, enjoyed by a defendant in the higher Courts, of questioning the validity of the registration of the mark which he has been charged with fraudulently imitating. *Primâ facie,* one would think that the criminal charge should not deprive him of that advantage, but there would seem to be no judicial expression of opinion of the question.

## Threats Against Infringers.

The proprietor of a Trade Mark may give notice that his mark is being infringed, and that he intends to take proceedings, without rendering himself liable under the Statute to an action for threats, and he cannot be restrained by injunction from doing so (Colley v. Hart). But statements not made in good faith and calculated to injure the trade of another, or amounting to trade libel or slander of title, may be restrained (Thorley's Cattle Co. v. Massam; Coulson v. Coulson; Royal Co. v. Wright and Co.). It appears from the last-mentioned case that even when the statements complained of are untrue and made maliciously, the plaintiff must prove special damage. But mere puffing of one's own goods, in however extravagant terms, is not a libel on the goods of rival traders (Mellin v. White).

## Loss of Rights Through Delay in Enforcing Them.

A man may by his own laches lose to a greater or less extent his right to that protection which he would have obtained had he come to the Court with reasonable promptitude. In fact, that which has originally been a valid Trade Mark the property of an individual or firm entitled to protection, may become *publici juris,*—that is to say, the use of it may be thrown open to the public,—by its proprietor allowing his right to be so habitually infringed that the Trade Mark no longer conveys to those who see it the impression that the goods to which it is attached are of his manufacture. A short acquiescence may properly induce the Court not to interfere *ex parte.* A longer acquiescence may, under the circumstances, throw serious doubt upon the right of the plaintiff and induce the Court not to interfere by an interlocutory order, even when applied for on notice. And it is not suffi-

cient for the plaintiff to commence proceedings promptly; if he wishes for an interlocutory injunction he must bring on his motion at once, or the Court will hold that he has shown by his own conduct that he does not consider such interference to be imperative.

But where a Trade Mark has been infringed, and the owner has not been aware that this has been the case, he has been guilty of no delay in taking steps to put an end to the fraud; and he will, therefore, not be deprived of his rights by reason of his having taken no proceedings while he was ignorant of the infringement. Hence, where a defence of delay is set up, the evidence must go to show, not merely that the plaintiff might have been aware of the infringement which was going on, but that he actually was so, and that it was with such knowledge that he remained quiescent.

In Powell v. Birmingham Vinegar Brewery Co. it is said: "There is another way in which a name originally a good Trade Name may lose its character and become *publici juris, i.e.,* where the first person using the name does not claim the right to prevent others from using it, and allows other persons to use it without complaint. The name then comes to denote the article, and nothing more. The name becomes *publici juris,* and any one who is at liberty to make the article can sell it by the name by which it is usually known."

The mere fact that a name, lawfully adopted as a Trade Mark, has been extensively or generally used as the name of the article, will not dedicate it to the public, and deprive the original proprietor of his exclusive rights. This doctrine is laid down clearly in a number of recent cases. Thus, in Burton v. Stratton it is said: "If the primary object of the Trade Mark be to indicate origin or ownership, the mere fact that the article has obtained such a widespread sale that the mark has also become indicative of quality is not of itself sufficient to debar the owners of protection, or make it the common property of the trade. To hold otherwise would be to deprive the owner of the exclusive use of his Trade Mark just at the time when it had become most valuable to him, and stood most in need of protection. But if the name be suffered to come into general use without objection from the proprietor, it may become merely generic or indicative of quality."

# Part III.—Workers', Commonwealth, and Standardisation Marks; Patent, Design and Copyright Marks; and International Convention.

## "Workers'" Trade Marks.

As has been explained elsewhere, the right to ownership of a Trade Mark is consequential on the possession of the goodwill in the trade in the goods to which the mark is applied, and the Trade Mark rights are inseparable from the goodwill of the trade from which they are derived. Here, however, a worker or association not possessed of any goodwill or trade rights may register a mark and sue to recover damages for any unauthorised use of it; not only so, but such a Trade Mark is not subject to the provisions of Sections 15 to 73 of the Act, which limit the class of marks capable of registration, regulate official procedure in relation to the procuring of registration, and provide for alteration of the Register. Section 74 provides that such a mark to be capable of infringement must consist of a distinctive device, design, symbol or label for the purpose of indicating that articles to which it is applied are the exclusive production of the registrants. Section 75 provides that to be registrable such mark shall not be deceptively similar to any mark already registered, and that it may be removed for a "prescribed cause in a prescribed manner"; the regulations provide for the advertising of the application and settle a special opposition procedure. The mark must be so applied as to show clearly that it does not indicate any part of the goods not actually produced by the registrant, worker or association, and it must be applied either by the employer or by his authority. Workers' Marks cannot be used in connection with the primary products of the agricultural, viticultural (including wine-making), horticultural, dairying (including butter-making and cheese-making) or pastoral industries. A Workers' Mark is therefore not permissible on wheat or on wool, though it is permissible on bread or on cloth. The penaltv under this Section is £50, in addition to liability to forfeiture of the goods, and apparently also in addition to liability for damages to the registrants.

A critical examination of these clauses will make it clear that they are likely to cause inconvenience in practice. It is not possible to adopt a single "Union" mark for all goods, because such a mark would be inapplicable in the case of two lots of goods one of which is wholly made and the other only partly made by the registrant's association. How is a mark to be made to distinguish in the case of clothing made from Australian tweed with imported trimmings, or in

the case of a cycle "assembled" in Australia, but consisting entirely of parts imported, some in the rough and some in the finished state? or, in the case of tobacco made up from leaf partially manufactured before importation? If a single mark were adopted and applied indiscriminately to goods more or less wholly made and also to goods on which only some merely finishing touch is done by members of the registrant association, then clearly the mark would not fulfil its purpose. Hence a more or less elaborate system of marks would appear to be required for practical purposes, and these marks should vary in material particulars so as to be clearly distinguishable and free from deceptive similarity. It would seem to be necessary to take each particular case on its merits and ensure that the Workers' Mark is applied in such manner as "clearly to indicate that its application does not refer to describe or designate the parts of the goods not being the production of the registrant, worker, or of members of the registrant association" (Sec. 74).

## Standardisation Marks.

When a Commonwealth or State authority, or a person or an association authorised by the Minister, undertakes the examination of any goods as to their origin, material, quality, accuracy, or other characteristic, or the mode of their manufacture, and adopts a certifying mark, such mark may be registered by such authority, person or association. Similarly, a Commonwealth or State authority (but not a person or association) may register a mark certifying as to conditions of manufacture. Such registrations will have the like effect as ordinary Trade Mark registrations, although the registrants do not own the goods or the trade in them; but the registration cannot be assigned without the permission of the Minister. Under this clause (22) the Astronomer may register a mark to be applied to instruments tested at the Observatory, or Municipal authorities a mark to be applied to sanitary fittings, a Goldsmiths' Association "Hall Marks" for plate, a Wheat Buyers' Association grade marks for wheat, or a Merchants' Association quality marks for groceries or other goods; or a State Agricultural Department a mark certifying the conditions under which butter has been manufactured.

## "Commonwealth" Trade Mark.

Goods produced in Australia may have four sets of "marks" applied to them—(*a*) the Trade Mark proper, which may be quite independent of the manufacturer's name and label; (*b*) the "Workers'" Marks; (*c*) the "Standardisation" Mark; and (*d*) the "Commonwealth" Mark. The Commerce Act and Regulations thereunder also provide for the application of "Trade Descriptions" in certain cases. The Minister is to be the registered proprietor of the "Commonwealth" Mark, and he may adopt any mark without restriction so long as it is "a distinctive device or label bearing the words 'Australian Labour Conditions,' without mentioning any State. It cannot be removed from the Regis-

ter except by the Minister, and Sections 15 to 73 of the Act, as in the case of the "Workers'" Mark, do not apply to it. The "Commonwealth" Mark may only be used with the authority of the Minister by the "first proprietor" upon goods manufactured by him or at his cost under the provisions of an award or order or an agreement under an industrial law or upon goods specially declared by resolution of both Houses of the Federal Parliament to have been produced under fair and reasonable conditions as to remuneration of the labour employed in connection with their manufacture. The penalty for infringement is £50, and in the case of applying the mark to imported goods £100. Special application must be made for permission to use the Commonwealth Trade Mark; and a record will be kept in the Register of persons authorised to use it.

## "Patent" Marks.

Section 125 of the Patents Act is as follows:—

> 125. It shall be the duty of all patentees and their assigns and legal representatives and of all persons making or vending any patented article for or under them to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented" together with the day and year the patent was granted and the number of the patent; or when from the character of the article this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed a label containing the like notice; and in any suit for infringement by the party failing so to mark no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make, use, or vend the article so patented.

Section 3 of the Commerce Act defines a "trade description" to include any description, statement, indication or suggestion, direct or indirect—"*f*: as to the goods being the subject of an existing patent, privilege, or copyright"; and such trade description is taken to have been applied even when not actually placed on the goods themselves or their wrappers, but is used in an invoice (Coppen v. Moore). The penalty is £100 when the transgressor fails to satisfy the Court that the act complained of was committed unknowingly, and Section 10 provides for forfeiture of the goods, subject to possible release on correction of the false mark. The Royal Arms should not be used as part of a patent mark.

It will be observed, therefore, that the Patents Act demands marking of patented articles in a prescribed style under penalty of loss of damages in infringement suits in respect of acts done without notice, and that the Commerce Act imposes a fine of £100 and forfeiture of the goods for using a Patent Mark where there is no patent.

An applicant for a Patent is not a "patentee," and articles which are the subject of pending applications for Patents should therefore not be marked "Patent." They may be marked "Patent applied for."

These provisions will give rise to much difficulty. Nearly every article of trade or commerce is or has been directly or indirectly the subject of a Patent granted in Australia or elsewhere. Apparently the policy of the law is to require all goods to bear notice of the fact

when there is an existing Commonwealth Patent, and to prevent the use of a Patent Mark in all other cases, even where the articles are imported and are the subject of a Patent in the country from which they were shipped. A Patent Mark may be misleading even when applied to patented goods. Take, for instance, a phonograph. The modern talking machine is the subject of many hundreds of Patents taken out from time to time for various features of it. The earlier Patents have expired. Where such a machine contains only individual parts which is the subject of a Patent, may the mark be applied to the case containing the machine or to the machine itself? or must it be applied only to the patented part? And then, if the latter is the case, must a separate Patent Mark be applied to every separate patented part? How, for instance, would a Patent Mark be applied to the recording point or the reproducing button parts, which are hardly larger than a pin's head? Again, take the case of a rifle. There may be a Patent for the construction of the lock or for the process by which the steel in the barrel was made. Would a mark applied to the stock of the gun be a sufficient marking or a false marking in either or both these cases? Then in the case of expired Patents or Patents declared void it is doubtful if the application of a Patent Mark could be continued legitimately. A large proportion of imported goods are marked "Patent," the mark in many cases being cast on heavy parts. In practice, the existence of such a mark does not always mislead the public. No one imagines when he finds "Patent" on a motor-car that the intention is to represent the whole car as patented so that no part of it may be reproduced without infringing the Patent. The history of the modern auto runs through many hundreds of Patents. For instance, a great number of American cars made by various makers are constructed, so far as a certain feature of the engine is concerned, under the Selden Patent of 1895. Section 4900 of the American law demands that these goods shall be marked "Patent," and the American manufacturers must so mark them before sending them out of the factory. Then, on arrival here, the Australian law steps in and declares that unless there is an existing Australian Patent the importer is liable to £100 fine and forfeiture of the articles. Strictly speaking, the Australian law compels patentees to apply a Patent Mark to each and every patented article so as to distinguish what it is that is the subject of Patent in each case, and where there is no existing Patent it puts an obligation on merchants and traders to erase all Patent Marks.

The question of Patent Marks is an extremely complicated one, and it is quite clear that if the Customs authorities should assert their powers to the full in this connection the physical impossibility of abiding strictly by the letter of the law would be made clear.

Where a name is used in connection with a patented article, and the article is sold under that name during the life of the Patent, upon the expiration of the Patent the name becomes dedicated to the public, whether the name be an arbitrary one, or be the surname of the patentee or original manufacturer. It follows, as a matter of course, that, on the termination of the Patent, there passes to the public the right to make the machine in the form in which it was constructed

during the Patent. It equally follows from the cessation of the monopoly, and the falling of the patented device into the domain of things public, that, along with the public ownership of the device, there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly in consequence of the designation having been acquired by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly, by his having so connected the name with the machine to lend countenance to the resulting dedication.

Thus, as every one, at the expiration of the Patent, had a clear right to manufacture and vend what was known as the "Singer" sewing-machine, the plaintiff could acquire no exclusive right to the name "Singer," but could, by proper Trade Mark, appropriate to itself names or devices indicating its own manufacture of such machines.

In the English case of Linoleum Mfg. Co. v. Nairn, the plaintiffs claimed the exclusive right to the use of the word "Linoleum" as a Trade Mark for the substance which had been covered by Patents which, prior to the time of the suit, had expired. The inventor of the new substance had given to it the name "Linoleum," and it had always been sold under that name during the life of the Patent. The Court said: "It appears that the defendants are now minded to make, as it is admitted they may make, that substance. I want to know what they are to call it. That is a question I have asked, but I have received no answer, and for this simple reason: that no answer could be given except that they must invent a new name. I do not take that to be the law. I think that, if 'Linoleum' means a substance which may be made by the defendants, the defendants may sell it by the name which that substance bears. In my opinion, it would be extremely difficult for a person who has been, by right of some monopoly, the sole manufacturer of a new article, and has given a new name to the new article, meaning that new article and nothing more, to claim that the name is to be attributed to his manufacture alone, after his competitors are at liberty to make the same article."

## "Designs" Marks.

Section 29 of the Designs Act is as follows:—

(1) The owner of a registered design shall cause each article to which the design is applied to be marked, before delivery for sale, with the prescribed mark to denote that the design is registered. Penalty: Twenty pounds.

(2) It shall be a defence to a prosecution under this section if the defendant proves to the satisfaction of the Court that he took all proper steps to ensure the marking of the article in accordance with sub-section (1) of this section.

Here a difficulty of the same class arises as in the case of the Patent Marks. Wall-papers, prints, collars, and other goods, the bulk of which are imported, are the subject of design registrations in England or other countries, and the registration mark will be found printed on or attached to them. Where the design is not registered in Australia this mark would need to be removed; it would probably not be sufficient to merely cover it.

## "Copyright" Marks.

British Copyright laws do not demand the marking of copyright works, though there is, in some cases, a necessity to insert some notice regarding translations and dramatisations. There is no obligation (except in the United States) on proprietors, importers or exporters to insert a Copyright Mark on works which are the subject of copyright registration. Where, however, works contain such a mark it is obligatory on importers and exporters to ascertain that the mark is not a false trade description within sub-section (*f*) of Section 3 of the Commerce Act. This difficulty will arise chiefly in connection with American works which the law of the United States requires to be marked on the title page with the word "Copyright," name of the registrant, and the year of registration, or with another entry consisting of a longer formula. Works not protected by Copyright laws operating in Australia but so marked would within Section 3 of the Commerce Act bear a false trade description, unless indeed the Customs authorities should see their way to assume, from the fact that the works contain the name of an American publisher, that the insertion of the copyright notice in the form quoted would not necessarily indicate Australian copyright, and thereby bring the importer or exporter within Clause 3, making him liable to forfeiture of the goods and fine of £100. (See Sections 9 and 10, Commerce Act.)

## International Convention.

The Act makes special provision for bringing the Commonwealth within the terms of the International Convention for the protection of Industrial Property in respect of Trade Marks. Similar provisions are contained in the Patents Act and in the Designs Act, but it is not necessary here to refer to the incidence of these latter. When the necessary administrative arrangements have been made, any person who has applied for protection for any Trade Mark, either in the United Kingdom or in any other State which is a party to the Convention, shall be entitled to registration of his mark in priority to other applicants, and the date of registration in the Commonwealth shall be the same date as the date of the original application abroad. *Per contra,* Australian applicants will be entitled to similar rights of priority in the United Kingdom and generally in the States parties to the Convention. In every case, however, applications intended to take advantage of the international arrangements must be made within six months of the original application, otherwise they will only be entitled to be dealt with in their ordinary order, and will have no rights of priority as against applications filed earlier. The operation of these sections of the Act depends, so far as foreign States are concerned, upon the issue of an Imperial Order in Council definitely declaring the application of the International Law in respect of such foreign States. The countries in the Convention are: Germany, Belgium, Brazil, Cuba, Denmark, and the Faroe Islands, Dominican Republic, Spain, United States, France, Algeria, and Colonies, Great Britain,

Ceylon, New Zealand, Italy, Japan, Mexico, Norway, Netherlands, Dutch East Indies, Surinam, Curacao, Portugal, with the Azores and Madeira, Servia, Sweden, Switzerland, Tunis.

As regards other British possessions, the Imperial Government is not called upon to make any Orders to give the provisions of the Act force. The Governor-General of the Commonwealth may issue an Order declaring reciprocity with any British possession whose laws offer similar privileges to Australian residents. It will be observed that these provisions do no more than ensure a right of priority of application as from the date of the filing of the application in the originating State. No title to registration is conferred in addition to that which may be claimed for the mark if it were submitted for registration under ordinary circumstances. The English Merchandise Act applies, not alone to Trade Marks registered in the United Kingdom, but to marks which either with or without registration are protected by law under the Convention arrangements. The Commonwealth Commerce Act, so far as it refers to registered Trade Marks, makes no provision corresponding with that of the English Merchandise Marks Act in favour of marks covered by the Convention arrangements. It remains to be said that the bulk of the provisions of the International Convention are inapplicable to Trade Marks; those above-mentioned securing priority being practically the only features of it which are reallv effective in this regard.

It is very probable that the necessary Orders will be issued at an early date bringing these international and intercolonial arrangements into force.

# APPENDIX.

## The Commonwealth of Australia.

## Trade Marks Act.

No. 20 of 1905.

An Act relating to Trade Marks.

## Part I.—Introductory.

1. This Act may be cited as the *Trade Marks Act* 1905.
2. This Act shall commence on a day to be fixed by proclamation not less than four months after the passing of this Act.
3. This Act is divided as follows:—


Part I.—Introductory.
Part II.—Administration.
Division 1.—The Minister, the Registrar, and the Trade Marks Office. Division 2.—The Transfer of the Administration of the State Trade Marks Acts.
Part III.—Registrable Trade Marks.
Part IV.—Registration of Trade Marks. Division 1.—General. Division 2.—Applications. Division 3.—Opposition. Division 4.—Registration and Effect of Registration. Division 5.—Renewal of Registration.
Part V.—Assignment of Trade Marks.
Part VI.—The Register of Trade Marks.
Part VII.—Workers' Trade Marks.
Part VIII.—The Commonwealth Trade Mark.
Part IX.—Protection of Trade Marks.
Part X.—Miscellaneous.

4. In this Act, except where otherwise clearly intended—

"The Court" means the High Court or the Supreme Court of the State in which the Trade Marks Office is situate or a Justice thereof.

"The Law Officer" means the Attorney-General or Crown Solicitor of the Commonwealth.

"Person" includes a body corporate and a firm and any association of persons bodies corporate or firms.

"The Register" means the Register of Trade Marks under this Act.

"Registered Trade Mark" means a trade mark registered under this Act.

"The Registrar" means the Registrar of Trade Marks.

"State Trade Marks Act" means any State Act relating to the Registration of Trade Marks.

"This Act" includes all regulations made thereunder.

5. Subject to this Act, or any Act of the Parliament, the common law of England relating to trade marks shall, after the commencement of this Act, apply throughout the Commonwealth.

Provided that this section shall not affect any right, privilege, obligation, or liability acquired, accrued, or incurred under the law of any State before the commencement of this Act.

6. The State Trade Marks Acts of each State shall, on the commencement of this Act, cease to apply to trade marks further than as follows:—

(*a*) The State Trade Marks Act under which a trade mark is registered shall continue to apply to that trade mark so long as the registration under that Act remains in force.

(*b*) Proceedings under a State Trade Marks Act, pending at the commencement of this Act, may be continued and completed under the State Trade Marks Act.

(*c*) Applications for the registration of trade marks may be received and dealt with under a State Trade Marks Act, if made by virtue of some right acquired, before the commencement of this Act, in pursuance of any International Convention for the protection of industrial property.

7.—(1.) The Registration of a trade mark under a State Trade Marks Act shall cease either—

(*a*) at the expiration of fourteen years from the commencement of this Act, or

(*b*) at the time when, under the State Trade Marks Act, the trade mark would, if after the commencement of this Act no fee for the continuance of its registration were paid, first become liable to removal from the register,

whichever first happens.

(2.) No fee shall be receivable nor shall any act be done after the commencement of this Act for the continuance of the registration of a trade mark under a State Trade Marks Act.

8.—(1.) The registered proprietor of a trade mark properly registered in any State under a State Trade Marks Act may make application for the registration of his trade mark under this Act.

(2.) The application shall, subject to paragraphs (3), (4) and (5) of this section, be dealt with in the same manner as other applications for registration of trade marks.

(3.) The trade mark may be registered even if it does not contain the essential particulars required by this Act, but subject, in that case, to such conditions and limitations as to mode or place or period of user as the Registrar, Law Officer, or Court thinks fit to impose.

(4.) Where the same trade mark or a nearly identical trade mark is owned or registered by another proprietor in any part of the Commonwealth in respect of the same goods, the trade mark may be registered subject to such conditions and limitations as to mode or place of user or otherwise as the Registrar, Law Officer, or Court thinks fit to impose to preserve the rights of each proprietor.

(5.) Where the trade mark or a nearly identical trade mark is common to the trade in another State, the registration under this Act shall confer no exclusive rights in that State on the registered proprietor, and that State may be excepted from the registration under this Act.

(6.) The registration of the trade mark under a State Trade Marks Act shall cease upon its registration under this Act.

9.—(1.) The unregistered proprietor of a trade mark in use in any State at the commencement of this Act may make application for the registration of his trade mark under this Act.

(2.) The application shall, subject to paragraphs (3), (4), (5), and (6) of this section, be dealt with in the same manner as other applications for registration of trade marks.

(3.) The trade mark may be registered if it could have been lawfully registered under the State Trade Marks Act in force, at the commencement of this Act, in the State in which the trade mark was then used, had an application for its registration been made before the commencement of this Act.

(4.) If the trade mark does not contain the essential particulars required by this Act, it may nevertheless be registered subject to such conditions and limitations as to mode or place, or period of user, as the Registrar, Law Officer, or Court thinks fit to impose.

(5.) Where the same trade mark or a nearly identical trade mark is owned or registered by another proprietor in any part of the Commonwealth in respect of the same goods, the trade mark may be registered subject to such conditions and limitations as to mode or place of user or otherwise as the Registrar, Law Officer, or Court thinks fit to impose to preserve the rights of each proprietor.

(6.) Where the trade mark, or a nearly identical trade mark, was, at the commencement of this Act, common to the trade in another State, the registration under this Act shall confer no exclusive rights in that State on the registered proprietor, and that State may be excepted from the registration under this Act.

## Part II.—Administration.

### Division 1.—The Minister, the Registrar, and the Trade Marks Office.

10. The Minister for Trade and Customs or other the Minister for the time being administering the Department of Trade and Customs shall be charged with the execution of this Act.

11.—(1.) There shall be a Registrar of Trade Marks.

(2.) Until the Governor-General otherwise determines the Commissioner of Patents shall be the Registrar of Trade Marks.

(3.) The Governor-General may appoint a Deputy Registrar of Trade Marks who shall, subject to the control of the Registrar of Trade Marks, have all the powers conferred by this Act on the Registrar.

12. For the purposes of this Act an office shall be established which shall be called the Trade Marks Office, and a sub-office shall be established in every State other than the State in which the Trade Marks Office is established.

13. There shall be a seal of the Trade Marks Office, and impressions thereof shall be judicially noticed.

### Division 2.—The Transfer of the Administration of the State Trade Marks Acts.

14. On the commencement of this Act, the administration of the State Trade Marks Acts of all the States shall be transferred to the Commonwealth and thereupon—

(*a*) the State Trade Marks Acts of each State shall, so far as they have any relation to trade marks, cease to be administered by the State, and shall thereafter be administered by the Commonwealth so far as is necessary for the purpose of completing then pending proceedings and of giving effect to then existing rights, and the Registrar shall collect for each State the fees which become payable thereunder; and

(*b*) all powers and functions under any State Trade Marks Act vested in the Governor of a State or in the Governor with the advice of the Executive Council of a State or in any Minister officer or authority of a State shall vest in the Governor-General or in the Governor-General in Council or in the Minister officer or authority exercising similar powers under the Commonwealth as the case requires or as is prescribed; and

(*c*) all records registers deeds and documents of the Trade Marks Office of each State vested in or subject to the control of the State shall, by force of this Act, be vested in and made subject to the control of the Commonwealth.

## Part III.—Registrable Trade Marks.

15. A registrable trade mark shall consist of essential particulars with or without additional matter.

16. The essential particulars of a registrable trade mark shall be one or more of the following particulars:—

(*a*) A name or trading style of a person printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature or copy of a written signature of the person applying for registration thereof or some predecessor in his business; or

(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

(*d*) An invented word or invented words; or

(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name used or likely to be understood in a geographical sense.

17. The additional matter which may be added to the essential particulars of a registrable trade mark shall be—

(*a*) Any letters, words, or figures; or

(*b*) Any combination of letters, words, or figures, or of any of them.

18. Except in the case of a trade mark properly registered in any State under a State Trade Marks Act, a registrable trade mark must not contain—

(*a*) the words "Trade Mark," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is forgery" or words to the like effect; or

(*b*) a representation of the King, the Queen, or any member of the Royal Family, or of the Royal Crown.

19. A registrable trade mark must not contain—

(*a*) the word "Royal" or any word, letter, or device, indicating Royal or Government patronage; or

(*b*) a representation of the Royal Arms, or of the national flag of the United Kingdom, or of the flag of the Commonwealth, or of the national arms of the United Kingdom, or of the arms or seal of the Commonwealth or any State; or

(*c*) a representation of any living person without his written consent.

20. In determining whether any particular of a trade mark is distinctive, regard may be had, in the case of a trade mark in actual use, to the extent to which user has rendered the trade mark or the particular distinctive for the goods with respect to which the trade mark is sought to be registered.

21. A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trade mark is so limited shall be taken into consideration by any tribunal in determining whether it is distinctive or not. If a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

STANDARDISATION MARKS.

22.—(1.) Where any Commonwealth or State authority, or any association or person, undertakes the examination of any goods in respect of origin, material, mode or conditions of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by a mark used upon or in connexion with such goods, the Minister may, if he judges it to be to the public advantage, permit the authority association or person to register the mark as a trade mark in respect of such goods, whether the authority association or person is or is not a trader, or is or is not possessed of a goodwill in connexion with such examination and certifying.

(2.) When registered, the trade mark shall be deemed in all respects to be a registered trade mark, and the authority, association, or person to be the registered proprietor thereof, save that the trade mark shall not be transmissible or assignable except with the permission of the Minister.

(3.) This section shall as to conditions of manufacture apply to Commonwealth and State authorities only.

## Part IV.—Registration of Trade Marks.

DIVISION 1.—GENERAL.

23. A trade mark must be registered in respect of particular goods or classes of goods as prescribed.

24.—(1.) If a trade mark—

(*a*) contains parts not separately registered by the proprietor as trade marks, or

(*b*) contains matter common to the trade or otherwise of a non-distinctive character,

the Registrar or the Law Officer or the Court, in deciding whether the trade mark shall be entered or shall remain upon the register, may in his or its discretion require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any of those parts, or of that matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they think needful for the purpose of defining his rights under the registration.

Provided always that no such disclaimer shall affect any rights of the proprietor of the trade mark except such as depend upon its registration.

(2.) The fact that a mark or matter therein is publicly and honestly used by more than three several persons in any one State as a mark on or in connexion with similar goods shall be treated as conclusive evidence that it is common to the trade.

25. Except by order of the Court, the Registrar shall not register in respect of goods a trade mark identical with one belonging to a different proprietor which is already on the register in respect of the like goods, or class of goods, or so nearly resembling such a trade mark as to be likely to deceive.

26. Where the name or a representation of a living person or a person believed by the Registrar to be living appears on a trade mark, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeeds with the registration of the trade mark.

27. Where each of several persons applies to be registered as the proprietor of the same trade mark or of nearly identical trade marks in respect of the like goods or class of goods, the Registrar may refuse to register the trade mark until the rights of the applicants have been determined, and may himself submit or require the applicants to submit their rights to the Court.

28. In case of honest concurrent user or of special circumstances the Registrar, Law Officer, or the Court may, in his or its discretion, permit the registration of the same trade mark or of nearly identical trade marks for the like goods or class of goods by more than one proprietor, subject to such conditions and limitations as to mode or place of user or otherwise as he or it thinks fit to impose.

## Associated and Series Marks.

29.—(1.) Where application is made for the registration of a trade mark so nearly resembling a trade mark of the applicant which is already on the register as to be likely to deceive or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that the trade marks shall be entered on the register as associated trade marks.

(2.) If the proprietor of a trade mark claims to be entitled to the exclusive use of any part of it separately he may, if the part satisfies all the conditions of a trade mark, register it as a separate trade mark.

(3.) When a part of a registered trade mark is registered separately, it and the trade mark of which it forms a part shall be deemed to be associated trade marks, and shall be entered on the register as such, and the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of the part separately registered as a trade mark.

(4.) Except for the purpose of assignment or transmission, and subject to the provisions of this Act as to use of associated trade marks, associated trade marks shall be deemed to be registered independently.

30. Where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the Registrar, Law Officer, or the Court, as the case may be, may, if and so far as he or it thinks fit, accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the user of the first-mentioned trade mark.

31.—(1.) When a person claiming to be the proprietor of several trade marks, which while resembling each other in the essential particulars thereof yet differ in respect of—

(*a*) statements of the goods for which they are respectively used or proposed to be used, or

(*b*) statements of number, price, quality, or names of places,

seeks to register such trade marks, they may be registered as a series in one registration.

(2.) All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

### Division 2.—Applications.

32.—(1.) Any person, claiming to be the proprietor of a trade mark, may make application to the Registrar for the registration of his trade mark.

(2.) The application must be made in the form prescribed and must—

(*a*) specify the goods or class of goods in respect of which the applicant desires the trade mark to be registered;

(*b*) state what are the essential particulars of his trade mark and disclaim any right to the exclusive use of the matter added to the essential particulars of his trade mark; and

(*c*) state an address within the Commonwealth as an address for service:

Provided that an applicant need not disclaim his own name or address or the foreign equivalents thereof or that of a predecessor in business.

(3.) Separate applications must be made for the registration of a trade mark in respect of each class of goods in respect of which the applicant desires it to be registered.

33.—(1.) Every application must be lodged by being left at or sent by post to the Trade Marks Office or a sub-office.

(2.) Such application shall be forthwith referred by the Registrar to an examiner, who shall ascertain and report whether the trade mark is a registrable trade mark, and whether it is identical with a trade mark already on the register under this Act or any State Trade Marks Act in respect of the like goods or class of goods, or so nearly resembles the latter trade mark as to be likely to deceive, and whether the trade mark or any matter therein is common to the trade.

(3.) Subject to this Act the Registrar may either accept the application, with or without modifications or conditions, or refuse it.

34.—(1.) An appeal shall lie to the Law Officer from any conditional acceptance or any refusal by the Registrar of the application.

(2.) The Law Officer shall hear the applicant and the Registrar, and shall decide whether and subject to what conditions or modifications (if any) the application shall be accepted.

(3.) An applicant aggrieved by the decision of the Law Officer may in the time and in the manner prescribed appeal to the Court.

(4.) The Court shall hear the applicant and determine whether the application ought to be refused or ought to be accepted with or without any modifications or conditions.

35. If the applicant so desires, he may appeal direct from the Registrar to the Court without any appeal to the Law Officer.

36. If the application is accepted with or without conditions or modifications it shall forthwith be advertised in the prescribed manner.

37. If, by reason of default on the part of the applicant, the registration of a trade mark has not been completed within twelve months from the date of the lodging of the application, the Registrar shall give notice of the non-completion to the applicant, and if, at the expiration of fourteen days from that notice or such further time as the Registrar in special cases permits, the registration is not completed, the application shall be deemed to be abandoned.

### Division 3.—Opposition.

38. Any person may, within three months after the advertisement of the application or such further time not exceeding three months as the Registrar on application made within the first period of three months allows, lodge at the Trade Marks Office a notice of opposition in duplicate to the registration of the trade mark, setting out the grounds on which he relies to support his notice.

39. Every notice of opposition shall state an address in Australia as an address for service.

40. The Registrar shall send a duplicate of the notice of opposition to the applicant.

41.—(1.) Within three months after the lodging of notice of opposition or such further time not exceeding three months as the Registrar on application made within such first mentioned three months allows, the applicant may lodge at the Trade Marks Office a counter-statement in duplicate, setting out the grounds on which he relies to support his application.

(2.) If the applicant fails to so lodge a counter-statement he shall be deemed to have abandoned his application, and in that event he shall not be liable for costs, but if he lodges a counter-statement and thereafter abandons his application he shall, unless the Registrar otherwise orders, pay to the opponent such costs as the Registrar allows.

(3.) The Registrar shall send a duplicate of the counter-statement to the opponent.

42.—(1.) The Registrar shall fix a day for the hearing of the application, and shall give notice thereof to the applicant and to the opponent.

(2.) On the day so fixed, or on any other day to which the hearing is adjourned, the Registrar shall hear the applicant and the opponent, and shall decide whether the application is to be refused or whether it is to be granted either with or without any modifications or conditions.

43.—(1.) Any party aggrieved by the decision of the Registrar may in the time and in the manner prescribed appeal to the Law Officer.

(2.) The Law Officer shall hear the applicant and the opponent, and may determine whether the application ought to be refused or ought to be granted with or without any modifications or conditions.

44.—(1.) Any party aggrieved by the decision of the Law Officer may in the time and in the manner prescribed appeal to the Court.

(2.) The Court shall hear the applicant and the opponent, and determine whether the application ought to be refused or ought to be granted with or without any modifications or conditions.

45. If either party so desires and gives written notice thereof the appeal shall be taken direct from the Registrar to the Court without any appeal to the Law Officer.

46. If a person giving notice of opposition or appeal does not reside in Australia, the Registrar Law Officer or the Court may order him to give security for costs, and if the order is not complied with the opposition or appeal shall be deemed to be abandoned.

DIVISION 4.—REGISTRATION AND EFFECT OF REGISTRATION.

47. When an application for registration has been accepted and has not been opposed and the time for notice of opposition has expired, or has been opposed and has been granted, the Registrar shall register the trade mark as on the date of the lodging of the application, which date shall be deemed to be the date of the registration, and shall issue to the applicant a certificate of registration of the trade mark in the prescribed form.

48. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

49.—(1.) Subject to this Act the person for the time being entered in the register as proprietor of a trade mark shall have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment.

(2.) No entry of any name shall affect the right of any owner of the same name to use it or its foreign equivalent.

(3.) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

50. The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark upon the goods in respect to which it is registered and of the validity of the registration.

51. The registration of a person as proprietor of a trade mark shall, after the expiration of five years from the date of registration (in the absence of fraud) be conclusive evidence of the validity of the registration, and, subject to this Act, of his right to the exclusive use of the trade mark in respect of the goods in respect of which it is registered, upon the registered proprietor proving that he or his predecessors in title have continuously used the trade mark in respect of the goods to a substantial extent for the five years immediately preceding the commencement of the legal proceedings.

For the purposes of this section user shall be deemed to be continuous if there has been no actual interruption thereof for a longer total period than twelve months.

52. No person shall be entitled to institute any proceeding to prevent or recover damages for the infringement of a trade mark, unless in the case of a registrable trade mark it is registered under this Act or a State Trade Marks Act.

53. The rights acquired by registration of a trade mark shall be deemed to be infringed by the use, in respect of the goods in respect of which it is registered, of a mark substantially identical with the trade mark or so nearly resembling it as to be likely to deceive.

In an action for the infringement of a trade mark the Court, in trying the question of infringement, shall admit evidence of the usages of the trade in respect to the get-up of those goods and of any trade marks or get-up legitimately used in respect of them by other persons.

### Division 5.—Renewal of Registration.

54. The Registrar may, on application made by the registered proprietor of a trade mark in the prescribed manner, at any date not later than fourteen years from the date of the original registration or the last renewal of registration, as the case may be (in this Division termed "the date of the last registration"), renew the registration of the trade mark for a period of fourteen years from the date of the expiry of the period of the last registration.

55.—At the prescribed time before the expiration of fourteen years from the date of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor or his agent in Australia of the date at which the existing registration will expire and the conditions as to proof of substantial user and as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, but any party aggrieved shall have a right to appeal in manner prescribed.

56. Where a trade mark has been removed from the register for non-payment of the prescribed fee the Registrar may within three months from such removal if satisfied that it is just so to do restore such trade mark to the register on payment of the prescribed additional fee for renewal.

57. Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for registration during one year next after the date of the removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that the non-payment of the fee arises from the death or bankruptcy or liquidation of the proprietor of the trade mark, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.

## Part V.—Assignment of Trade Marks.

58. A trade mark when registered may be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or class of goods in respect of which it has been registered and shall be determinable with that goodwill.

59. In any case where by reason of dissolution of partnership or other cause a person ceases to carry on business, and the goodwill

of the person does not pass to one successor but is divided, the Court may (subject to the provisions of this Act as to associated trade marks and series of trade marks), on the application of any of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications as it thinks necessary in the public interest.

60. Associated trade marks may be assigned or transmitted only as a whole.

## Part VI.—The Register of Trade Marks.

61. There shall be kept at the Trade Marks Office a Register of Trade Marks wherein shall be entered particulars of—

(*a*) all registered trade marks, with the names and addresses of their proprietors, together with the date of registration and expiry thereof;

(*b*) notifications of assignments and transmissions, and disclaimers; and

(*c*) any other matters relating to registered trade marks which are prescribed.

62. Where a trade mark has been lawfully assigned or transmitted, a notification of the assignment or transmission, in the form and authenticated in the manner prescribed, may be given to the Registrar, who shall thereupon register the assignment.

63. No notice of any trust, expressed implied or constructive, shall be entered in the register, or be received by the Registrar.

64. The register shall be open to the inspection of the public at all convenient times, on payment of the prescribed fee.

65. Certified copies of entries in the register shall be given to any person applying for them on payment of the prescribed fee.

66. Documents purporting to be copies of or extracts from the register, and to be certified by the Registrar and sealed with the seal of the Trade Marks Office, shall be admitted in evidence in all Federal and State Courts without further proof or production of the originals.

67. No person shall wilfully—

(*a*) Make any false entry in the register; or

(*b*) Make any writing falsely purporting to be a copy of an entry in the register; or

(*c*) Produce or tender in evidence any writing falsely purporting to be a copy of an entry in the register.

Penalty: Three years' imprisonment.

68.—(1.) The Registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the register by—

(*a*) correcting any error in the name or address of the registered proprietor of the trade mark; or

(*b*) altering the name or address of the registered proprietor who has changed his name or address; or

(*c*) cancelling the registration of the trade mark; or

(*d*) striking out any goods or classes of goods from those in respect of which the trade mark is registered; or

(*e*) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.

(2.) Where the register has been amended or altered under this section the Registrar may—

(*a*) cancel the certificate of registration of the trade mark, and issue a new certificate of registration; or

(*b*) make such amendments or alterations in the certificate of registration of the trade mark as are rendered necessary by the amendment or alteration of the register.

69. Subject to the provisions of this Act, where a person becomes entitled to a registered trade mark by assignment, transmission, or otherwise, the Registrar shall on request, and on proof of title to his satisfaction, cause the name and address of the person to be entered on the register as proprietor of the trade mark.

70. The registered proprietor of a trade mark may apply to the Court for leave to add to or alter the trade mark in any manner not substantially affecting its identity, and the Court may refuse or grant the leave on such terms as it thinks fit. If leave be granted, the Registrar shall, on service of the order of leave, cause the register to be altered in accordance with the order, and shall, in the prescribed manner, advertise the trade mark as altered.

71.—(1.) Subject to this Act, the Court, on the application of any person aggrieved or of the Registrar, may order the rectification of the register by—

(*a*) the making of any entry wrongly omitted to be made in the register; or

(*b*) the expunging of any entry wrongly made in or remaining on the register; or

(*c*) the insertion in the register of any exception or limitation affecting the registration of a trade mark which in the opinion of the Court ought to be inserted; or

(*d*) the correction of any error or defect in the register.

(2.) The Registrar shall only make application to the Court under this section in cases where he thinks the application necessary or desirable in the public interest.

(3.) Notice of every application to the Court pursuant to this section (other than an application by the Registrar) shall be given to the Registrar, who may be heard thereon.

72.—(1.) The Court may, on the application of any person aggrieved, if it is shown that there has been no *bonâ fide* user of a trade mark for a consecutive period of three years since the date of the last registration thereof, order its removal from the register, unless it was at the date of the application in *bonâ fide* use and had been

so for a period of six months immediately prior to the date of the application.

(2.) For the purpose of this section *bonâ fide* user or use means user or use of a trade mark in respect of the goods in respect of which it is registered for the purposes of trade by the proprietor of the trade mark or a predecessor in title.

73. The Registrar, upon being served with any order of the Court for the rectification of the register or for the removal of the registration of a trade mark from the register by the party seeking to enforce it, shall cause the rectification or removal to be made accordingly.

## Part VII.—Workers' Trade Marks.

74.—(1.) No person shall—

(*a*) falsely apply to any goods for the purpose of trade or sale; or

(*b*) knowingly sell or expose for sale, or have in his possession for sale or for any purpose of trade or manufacture, any goods to which there is falsely applied; or

(*c*) knowingly import into Australia any goods not produced in Australia to which there is applied

a mark which is a distinctive device, design, symbol, or label registered by any individual Australian worker or association of Australian workers corporate or unincorporate for the purpose of indicating that articles to which it is applied are the exclusive production of the worker or of members of the association (and which mark is hereby declared to be a workers' trade mark), or any mark substantially identical with a registered workers' trade mark, or so nearly resembling it as to be likely to deceive.

(2.) The workers' trade mark is falsely applied unless in truth—

(*a*) the goods to which it is applied are exclusively the production of the worker or of members of the association; or

(*b*) the goods to which it is applied are in part but not exclusively the production of the worker or of members of the association, and the mark is applied in such manner as clearly to indicate that its application does not refer to, describe, or designate the parts of the goods not being the production of the worker or of members of the association; and

(*c*) the mark is applied to the goods (being goods produced in Australia) by the employer for whom they are produced, or, with the authority of the employer, by the worker or a member of the association registering the mark.

(3.) In this section—

"Association" includes any number of associations acting together, and in such case the members of the "association" shall be the members of the associations which are acting together;

"Production" means production, manufacture, workmanship, preparation, or product of labour;

"Produced" has a meaning corresponding with "production."

Penalty: Fifty pounds, in addition to any liability to forfeiture provided by law.

75.—(1.) A worker or association may register a workers' trade mark in the prescribed manner and shall thereupon be deemed the registered proprietor thereof, and be entitled to institute legal proceedings to prevent and recover damages for any contravention of this Part in respect of that trade mark.

(2.) A workers' trade mark may be removed from the register for the causes and in the manner prescribed, and subject thereto the registration of the trade mark shall continue for fourteen years, at the expiration of which it shall cease unless renewed in the manner prescribed.

(3.) A workers' trade mark shall not be capable of assignment either by act of the parties or by operation of law.

(4.) Parts III., IV., V., and VI. of this Act shall not apply in relation to workers' trade marks.

(5.) A workers' trade mark shall not be registered if it is substantially identical with any registered trade mark within the meaning of this Act or so nearly resembles it as to be likely to deceive.

76. Nothing in this Part shall be so construed as to make it lawful for any person or association or combination of persons to do any act which it would have been unlawful for such person, association, or combination of persons to do before the commencement of this Act.

77. This Part shall not apply to any primary products of the agricultural, viticultural (including wine-making), horticultural, dairying (including butter-making and cheese-making), or pastoral industries.

## Part VIII.—The Commonwealth Trade Mark.

78.—(1.) This Part shall apply to all goods included in or specified by a resolution passed by both Houses of the Parliament that in their opinion the conditions as to the remuneration of labour in connexion with their manufacture are fair and reasonable.

(2.) A resolution shall be deemed to have been passed at the commencement of this Act by both Houses of the Parliament that the conditions as to the remuneration of labour are fair and reasonable in respect of goods which are manufactured in any part of the Commonwealth under conditions as to the remuneration of labour prescribed, required, or provided in relation to the goods, by an industrial award or order, or an industrial agreement, under an industrial law.

(3.) In this Part "an industrial law" means any Act or State Act existing at the commencement of this Act and providing for conciliation or arbitration or both conciliation and arbitration, or the determination of the remuneration of labour in connexion with industrial matters or the manufacture of goods, or any statutory modification

amendment or re-enactment thereof respectively, or any Act or State Act passed after the commencement of this Act and declared by resolution of both Houses of the Parliament to be an industrial law within the meaning of this Part; and "industrial award or order" includes any determination of any Special Board or Court under an industrial law.

(4.) A resolution passed or deemed to have been passed as aforesaid may be by both Houses of the Parliament revoked in whole or in part, and thereupon this Part shall to the extent of the revocation cease to apply.

79.—(1.) The Minister may cause to be designed and registered a trade mark (in this Part called the Commonwealth Trade Mark), consisting of a distinctive device or label bearing the words "Australian Labour Conditions."

(2.) The Commonwealth trade mark shall not contain the name of or indicate any State.

(3.) Parts III., IV., V., and VI. of this Act shall not apply in relation to the Commonwealth trade mark.

80.—(1.) Upon the registration of the Commonwealth trade mark, the Minister shall be deemed to be the proprietor thereof, and shall be entitled to prevent the unauthorized application of the Commonwealth trade mark.

(2.) The rights of the proprietor of the Commonwealth trade mark shall be deemed to be infringed by the unauthorized application to goods of a mark identical or substantially identical with the Commonwealth trade mark, or so nearly resembling it as to be likely to deceive.

(3.) The Minister may sue to prevent infringement of the Commonwealth trade mark.

81. The application of the Commonwealth trade mark to goods shall be deemed to be unauthorized unless—

(*a*) it is applied by or by direction of the first proprietor of the goods, and is so applied by the authority of the Minister; and

(*b*) it is applied to goods to which this Part applies; and

(*c*) the first proprietor of the goods has personally manufactured them, or has paid for the labour other than his own in connexion with their manufacture at least the minimum amount prescribed, required, or provided to be paid to persons actually making the goods by an industrial award or order, or an industrial agreement under an industrial law.

82.—(1.) The authority of the Minister to any person to apply the Commonwealth trade mark may be given either generally or in respect of specific goods, and shall be given if in his opinion the trade mark will not be applied except as authorized by this Part.

(2.) The Minister may revoke his authority in whole or in part if in his opinion a person to whom it has been given has applied or is likely to apply the trade mark in a manner unauthorized by this Part.

83.—(1.) No person shall wilfully infringe the rights of the Minister as proprietor of the Commonwealth trade mark.

Penalty: Fifty pounds.

(2.) No person shall knowingly sell or expose for sale, or have in his possession for sale or for any purpose of trade or manufacture, any goods to which any mark is applied in infringement of the rights of the Minister as proprietor of the Commonwealth trade mark.

Penalty: Fifty pounds.

84. No person shall knowingly import into Australia any goods, not manufactured or produced in Australia, to which there is applied—

(*a*) the Commonwealth trade mark, or

(*b*) a mark substantially identical with the Commonwealth trade mark, or

(*c*) a mark so nearly resembling the Commonwealth trade mark as to be likely to deceive.

Penalty: One hundred pounds in addition to any liability to forfeiture provided by law.

85. The Commonwealth trade mark may, on the application of the Minister, be removed from the register in the manner prescribed.

## Part IX.—Protection of Trade Marks.

86. Whoever—

(*a*) forges a registered trade mark; or

(*b*) falsely applies a registered trade mark to any goods; or

(*c*) makes any die, block, machine, or instrument for the purpose of forging or of being used for forging a registered trade mark; or

(*d*) disposes of or has in his possession any die, block, machine, or instrument for the purpose of forging or of being used for forging a registered trade mark,

shall, unless he proves that he acted without intend to defraud, be guilty of an indictable offence, and liable to imprisonment for any term not exceeding three years.

87. Whoever sells or exposes for sale, or has in his possession for sale or for any purpose of trade or manufacture, any goods to which any forgery of a registered trade mark is applied or to which any registered trade mark is falsely applied, shall be guilty of an offence against this Act, unless he poves—

(*a*) that he acted without intend to defraud; or

(*b*) that the goods were manufactured in or imported into Australia and the trade mark was applied to them before the commencement of this Act, and were held by him *bonâ fide* and without intend to defraud.

Penalty: One hundred pounds.

88. Whoever imports into Australia any goods to which any forgery of a registered trade mark is applied or to which a registered trade mark is falsely applied shall, unless he proves that he did not knowingly import the goods in contravention of this Act, be guilty of an offence against this Act.

Penalty: One hundred pounds.

89. Whoever aids abets counsels or procures or is in any way knowingly directly or indirectly concerned in or privy to—

(*a*) the commission of any offence against this Act; or

(*b*) the commission of any act outside Australia which if committed in Australia would be an offence against this Act,

shall be guilty of an offence against this Act.

Penalty: One hundred pounds.

90.—(1.) The following goods are prohibited to be imported, and, if imported, may be seized as forfeited to the King:—

(*a*) all goods to which any forgery of a registered trade mark is applied, or to which any registered trade mark is falsely applied; and

(*b*) all goods manufactured at any place outside Australia and having applied to them any trade mark being the registered trade mark of any manufacturer dealer or trader in Australia, unless the trade mark is accompanied by a definite indication of the country in which the goods were made or produced.

(2.) Subject to the regulations, the Comptroller-General, or on appeal from him the Minister, may, if in his opinion the contravention has not occurred either knowingly or negligently, permit any goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General that the improper marks will be effectually removed from the goods or that the goods will be forthwith exported.

(3.) All imported goods liable to be seized under this section may be seized by any officer of Customs.

(4.) The provisions of the *Customs Act* 1901 shall apply to the seizure and forfeiture of goods under this section to the same extent as if they were prohibited imports under that Act.

(5.) Before taking any action under this section or permitting any officer of Customs to act thereunder, the Collector of Customs for the State may require any person requesting any action on the part of the Customs to give security in accordance with the regulations, but the Collector of Customs may act under this section without any request.

91. A person shall be deemed to forge a registered trade mark who either—

(*a*) without the assent of the proprietor of the trade mark or the authority of this Act, makes it or a mark so nearly resembling it as to be likely to deceive; or

(*b*) falsifies any registered trade mark, whether by alteration, addition, effacement, or otherwise.

92.—(1.) A trade mark shall be deemed to be applied to any thing if it is woven in, impressed on, worked into, or annexed or affixed to, the thing.

2. A trade mark shall be deemed to be applied to goods if—

(*a*) it is applied to the goods themselves; or

(*b*) it is applied to any covering, label, reel, or thing in or with which the goods are sold or exposed or had in possession for any purpose of trade or manufacture; or

(*c*) it is used in any manner likely to lead to the belief that it refers to or describes or designates the goods.

(3.) "Covering" includes any stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper; and "label" includes any band or ticket.

(4.) A trade mark shall be deemed to be falsely applied to goods if, without the assent of the proprietor of the trade mark or the authority of this Act, it or a mark so nearly resembling it as to be likely to deceive is applied to the goods.

93. In any indictment, information, pleading, or proceeding in relation to a registered trade mark, it shall not be necessary to set out a copy or fac-simile of the trade mark or a description of it, but the trade mark may be referred to as a registered trade mark.

## Part X.—Miscellaneous.

94. The Governor-General may make regulations, not inconsistent with this Act, prescribing the fees to be paid under this Act and all matters which by this Act are required or permitted to be prescribed or which are necessary or convenient to be prescribed for giving effect to this Act or for the conduct of any business relating to the Trade Marks Office.

95. In addition to any other powers conferred on it by this Act, the Court may in relation to any appeal or application under this Act—

(*a*) refuse to make any order;

(*b*) order any issue of fact to be tried in such manner as it directs;

(*c*) order any party to deliver to the Court or to the Registrar the certificate of registration of any trade mark; and

(*d*) order any party to pay costs to any other party.

96. The Registrar and the Law Officer, respectively, may for the purposes of this Act—

(*a*) summon witnesses;

(*b*) require the production of documents; and

(*c*) award costs against any party to any proceeding before him.

97. No person who has been summoned to appear as a witness before the Registrar or the Law Officer shall, without lawful excuse, and after tender of reasonable expenses, fail to appear in obedience to the summons.

Penalty: Fifty pounds.

98. No person who appears before the Registrar or the Law Officer as a witness shall, without lawful excuse, refuse to be sworn or make an affirmation or to produce documents or to answer questions which he is lawfully required to answer.

Penalty: Fifty pounds.

99. Any sum awarded for costs by the Registrar or the Law Officer may, in default of payment, be recovered in any civil court of competent jurisdiction as a debt due by the person against whom the order is made to the person in whose favour the order is made.

100.—(1.) In any legal proceedings in which the validity of the registration of a registered trade mark comes into question, the Court or a justice may certify that the right to the exclusive use of the trade mark came in question and was decided in favour of the registered proprietor of the trade mark, and then in any subsequent action for infringement of the trade mark the plaintiff on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or a Justice trying the subsequent action certifies that he ought not to have them.

(2.) In this section "Court" means any Federal Court or any superior State Court having jurisdiction to entertain an action for infringement of a trade mark, and "Justice" means a Justice of any such Court.

101. No person shall wilfully make any false statement or representation to deceive the Registrar or any officer in the execution of this Act, or to procure or influence the doing or omission of anything in relation to this Act or any matter thereunder.

Penalty: Three years' imprisonment.

102. The Registrar may at any time before registration of a trade mark permit the amendment of the application for the registration of the trade mark and may at any time permit the amendment of any notice of opposition on such terms as to costs or otherwise as he thinks just.

103. Where any discretionary power is by this Act given to the Registrar, he shall not exercise that power adversely to the applicant for registration of a trade mark without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

104. Where any prescribed fee is payable in respect of any act or document the Registrar may refuse to permit or perform the act or to receive or issue the document as the case requires until the fee payable in respect thereof is paid.

105. Where by this Act any time is specified within which any act or thing is to be done, the Registrar may, unless otherwise expressly provided, extend the time either before or after its expiration.

106. Any application, notice, or other document, authorized or required under this Act to be left, made, or given at the Trade Marks Office, or to the Registrar, or to any other person, may be sent by a prepaid letter through the post.

107.—(1.) Any address for service stated in any application or notice of opposition shall for all purposes of the application or notice of opposition be deemed to be the address of the applicant or opponent, as the case requires, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them to the address for service of the applicant or opponent, as the case requires.

(2.) Any address for service may be changed by notice in writing to the Registrar.

108. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or the regulations, then the guardian or committee (if any) of such incapable person, or if there be none any person appointed by any Federal or State Court or Justice thereof, possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of the incapable person or of any other person interested in the making of such declaration or doing such thing, may make the declaration or a declaration as nearly as corresponding thereto as circumstances permit, and do the thing in the name and on behalf of the incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

109. If a person who is party to a proceeding under this Act dies pending the proceeding, the Registrar may on request made in the prescribed manner, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if he is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without such substitution.

110. Subject to the regulations the Registrar may permit any agent to do, on behalf of any other person, any act in connexion with the registration of trade marks or any procedure relating thereto.

111. A certificate purporting to be under the hand of the Registrar and the seal of the Trade Marks Office as to any entry, matter, or thing which he is authorized by this Act to make or do shall be *primâ facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone.

112.—(1.) No person shall falsely represent that any trade mark, applied to any article sold by him, is registered.

Penalty: Five pounds.

(2.) A person shall be deemed, for the purposes of this section, to represent that a trade mark is registered, if he sells the article with the word "registered" or any word or words expressing or implying that a registration has been obtained for the trade mark stamped, engraved, or impressed on, or otherwise applied to, the article.

113. No person shall without the authority of the King, or of some member of the Royal Family, or of the Governor-General, or of the Governor of a State, or of some Department of the Government of the Commonwealth or a State (proof whereof shall lie upon the person accused), assume or use in connexion with any trade business calling or profession the Royal Arms, or arms so nearly resembling them as to be likely to deceive, in such a manner as to be likely to lead other persons to believe that he is carrying on his trade business calling or profession by or under such authority.

Penalty: Twenty pounds.

114. No scandalous design, and no mark the use of which would by reason of its being likely to deceive or otherwise be deemed dis-

entitled to protection in a court of justice, or the use of which would be contrary to law or morality, shall be used or registered as a trade mark or part of a trade mark.

### International and Intercolonial Arrangements.

115.—(1.) If upon the request of the Governor-General the King is pleased to apply to the Commonwealth any law of the United Kingdom for carrying into effect any arrangement made with the Government of any foreign State for the mutual protection of trade marks, then any person who has applied for protection for any trade mark in the United Kingdom or the Isle of Man, or in any foreign State with which the arrangement has been made, shall be entitled to registration of his trade mark under this Act in priority to other applicants, and such registration shall have the same date as the date of the original application in the United Kingdom or the Isle of Man or such foreign State as the case may be:

Provided that such application shall be made within six months from such person applying for protection in the United Kingdom or the Isle of Man or the foreign State with which the arrangement is in force:

Provided also that nothing in this section contained shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the date of the actual registration of his trade mark in the Commonwealth.

(2.) The use of the trade mark in the Commonwealth during the period aforesaid shall not invalidate its registration.

(3.) The application for the registration of a trade mark under this section must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall, in the case of foreign States, apply only to those foreign States with respect to which His Majesty, by Order in Council, has before or after the commencement of this Act declared the provisions of the aforesaid law to be applicable, and so long only in the case of each such State as the order continues in force with respect to that State.

116.—(1.) Where it is made to appear to the Governor-General that any British possession has made satisfactory provision for the protection in that possession of trade marks registered in the Commonwealth, the Governor-General may by order apply all or any of the provisions of the last preceding section with such variations or additions (if any) as to him seem fit to trade marks registered in that British possession.

(2.) An order under this section shall, from a date to be mentioned therein, take effect as if its provisions were contained in this Act, but it shall be lawful for the Governor-General to revoke any such order.

# Commerce (Trade Descriptions) Act.

No. 16 of 1905.

An Act relating to Commerce with other Countries.

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INTRODUCTORY.

1. This Act may be cited as the *Commerce (Trade Descriptions) Act* 1905, and shall commence on a day to be fixed by proclamation not being earlier than six months after the passing of this Act.

2. This Act shall be incorporated and read as one with the *Customs Act* 1901.

3. In this Act, unless the contrary intention appears—

"Officer" means an officer of Customs.

"Trade description," in relation to any goods, means any description, statement, indication, or suggestion, direct or indirect—

(*a*) as to the nature, number, quantity, quality, purity, class, grade, measure, gauge, size, or weight of the goods; or

(*b*) as to the country or place in or at which the goods were made or produced; or

(*c*) as to the manufacturer or producer of the goods or the person by whom they were selected, packed, or in any way prepared for the market; or

(*d*) as to the mode of manufactuing, producing, selecting, packing, or otherwise preparing the goods; or

(*e*) as to the material or ingredients of which the goods are composed, or from which they are derived; or

(*f*) as to the goods being the subject of an existing patent, privilege, or copyright,

and includes a Customs entry relating to goods; and any mark which according to the custom of the trade or common repute is commonly taken to be an indication of any of the above matters shall be deemed to be a trade description within the meaning of this Act.

"False trade description" means a trade description which, by reason of anything contained therein or omitted therefrom, is false or likely to mislead in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, which makes the description false or likely to mislead in a material respect.

4.—(1.) A trade description shall be deemed to be applied to goods if—

(*a*) it is applied to the goods themselves; or

(*b*) it is applied to any covering, label, reel, or thing used in connexion with the goods; or

(*c*) it is used in any manner likely to lead to the belief that it describes or designates the goods.

(2.) "Covering" includes any stopper, glass, bottle, vessel, box, capsule, case, frame, or wrapper; and "label" includes any brand or ticket.

### Inspection of Imports and Exports.

5.—(1.) An officer may inspect and examine all prescribed goods which are imported, or which are entered for export or brought for export to any wharf or place.

(2.) The officer may where practicable take samples of any goods inspected by him pursuant to this section, and the samples so taken shall be dealt with as prescribed.

(3.) For the purposes of this section an officer may enter any ship, wharf or place, and may open any packages, and may do all things necessary to enable him to carry out his powers and duties under this section.

6. Every person who intends to export any goods of a kind or class required under this Act to be inspected or examined by an officer shall, if required to do so by regulation, before the goods are shipped, give notice, in accordance with the regulations, to the Customs of his intention to export the goods and of the place where the goods may be inspected.

Penalty: Twenty pounds.

### Imports.

7.—(1.) The regulations may prohibit the importation or introduction into Australia of any specified goods unless there is applied to them a trade description of such character, relating to such matters, and applied in such manner, as is prescribed.

(2.) All goods imported in contravention of any regulation under this section may be detained by the Collector and may by direction of the Minister be seized as forfeited to the King.

(3.) Subject to the regulations, the Comptroller-General, or on appeal from him the Minister, may in any case, and if in his opinion the contravention has not occurred either knowingly or negligently shall permit any goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or importer upon security being given to the satisfaction of the Comptroller-General that the prescribed trade description will be applied to the goods or that they will be forthwith exported.

(4.) No regulation under this section shall take effect until after the expiration of not less than three months from notification in the *Gazette*.

8. All imported goods to which a trade description is by this Act or the regulations required to be applied, and which are found in Australia in any package or covering in which they were imported, and without the prescribed trade description, shall until the contrary is proved be deemed to have been imported in contravention of this Act or of the regulations as the case may be.

9. No person shall import any goods to which a false trade description is applied.

Penalty: One hundred pounds.

It shall be a defence to a prosecution for an offence against this section if the defendant proves that he did not knowingly import the goods in contravention of this section.

10. All goods to which any false trade description is applied are hereby prohibited to be imported, and shall if imported be forfeited to the King.

Provided that the Comptroller-General, or on appeal from him the Minister, may, if he is satisfied that any goods which have been seized as forfeited under this section were not knowingly imported in contravention of this Act, permit the importer to correct the false trade description, and may, when the correction has been made to his satisfaction, order the release of the goods, subject to the payment by the importer to the Customs of the expenses of the seizure, and thereupon the forfeiture shall be remitted.

### Exports.

11.—(1.) The regulations may prohibit the exportation of any specified goods, unless there is applied to them a trade description of such character, relating to such matters, and applied in such manner, as is prescribed.

(2.) All such goods to which the prescribed trade description is not applied, which are exported or entered for export or put on board any ship or boat for export or brought to any wharf or place for export, may be detained by the Collector, and may by direction of the Minister be seized as forfeited to the King.

(3.) Subject to the regulations the Comptroller-General, or on appeal from him the Minister, may in any case, and if in his opinion the contravention has not occurred either knowingly or negligently shall permit any goods which are liable to be or have been seized as forfeited under this section to be delivered to the owner or exporter, upon security being given to the satisfaction of the Comptroller-General that the goods shall not be exported in contravention of the regulations.

12. No person shall—

(*a*) knowingly apply any false trade description to any goods intended or entered for export or put on any ship or boat for export, or brought to any wharf or place for the purpose of export; or

(*b*) knowingly export or enter for export or put on any ship or boat for export any goods to which a false trade description is applied.

Penalty: One hundred pounds.

13. All goods to which any false trade description is applied are hereby prohibited to be exported, and shall, if exported or entered for export or put on any ship or boat for export, or brought to any wharf or place for the purpose of export, be forfeited to the King.

Provided that the Comptroller-General, or on appeal from him the Minister may, if he is satisfied that the owner of any goods which have been seized as forfeited under this section did not knowingly act in contravention of this Act, permit the correction of the false trade description, and may, when the correction has been made to his satisfaction, order the release of the goods, subject to the payment by the exporter of the expenses of the seizure, and thereupon the forfeiture shall be remitted.

14. Any goods intended for export which have been inspected in pursuance of this Act may in manner prescribed be marked with the prescribed trade description.

15. Sections seven and eleven of this Act shall not apply to any goods other than—

(*a*) articles used for food or drink by man, or used in the manufacture or preparation of articles used for food or drink by man; or

(*b*) medicines or medicinal preparations for internal or external use; or

(*c*) manures; or

(*d*) apparel (including boots and shoes) and the materials from which such apparel is manufactured; or

(*e*) jewellery; or

(*f*) seeds and plants.

16. The regulations under sections seven and eleven of this Act shall not prescribe a trade description which discloses trade secrets of manufacture or preparation, unless in the opinion of the Governor-General the disclosure is necessary for the protection of the health or welfare of the public.

## Miscellaneous.

17. The Governor-General may make regulations not inconsistent with this Act prescribing all matters and things required or permitted by this Act to be prescribed or which are necessary and convenient to be prescribed for carrying out or giving effect to this Act, and particularly for the analysis of samples taken under this Act, and the extent to which certificates of analysis shall be *primâ facie* evidence in proceedings under this Act of the facts therein stated.

18. Whoever aids, abets, counsels, or procures, or by act or omission is in any way, directly or indirectly, knowingly concerned in the commission of any offence against this Act shall be deemed to have committed that offence, and shall be punishable accordingly.

William Brooks & Co., Ltd., Printers, Sydney.

CONCERNING TRADE MARKS

— CONSULT —

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